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In The

Supreme Court of the United States

October Term, 1997

IN RE ROBERT LONARDO and RESTORATIVE CARE OF AMERICA, INC.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

I. Does the patent reexamination statute permit consideration of double patenting issues during the reexamination of a United States patent?

II. Is there a non-obviousness type of double patenting, beyond "same invention" and "obviousness-type" double patenting?

III. Once the new question of patentability for reexamination is determined by the Commissioner under 35 U.S.C. § 303 and ordered by the Commissioner under 35 U.S.C. § 304, can the Examiner thereafter broaden the reexamination to consider a different question of patentability?

A. Should a Writ of Certiorari issue because the Federal Circuit failed to decide this pivotal question which was before it on appeal?

IV. How much of the patent specification is readable into a "means plus function" clause under 35 U.S.C. § 112(6) for purposes of claim construction?

STATEMENT PURSUANT TO RULE 29.6

Restorative Care of America Incorporated has no parent company, and there are no nonwholly owned subsidiaries.

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Petitioner requests that this Court issue a Writ of Certiorari to review a judgment of the United States Court of Appeals for the Federal Circuit entered on July 8, 1997. A petition for rehearing and suggestion of rehearing *en banc* was denied on August 29, 1997.

OPINIONS BELOW

The July 8, 1997 decision of the Federal Circuit Court of Appeals is reported at 119 F.3d 960 (Fed. Cir. 1997), and is reprinted as Appendix A in this petition. The August 29, 1997 orde. of the Federal Circuit denying rehearing or rehearing *en banc* is reprinted as Appendix C. The October 13, 1995 decisions of the Patent Office Board of Appeals and Interferences are unreported, but reprinted as Appendices D, E and F of this petition. The relevant office actions of the Patent Office Examiner are unreported, and included as Appendices G, H, I, J and K of this petition.

STATEMENT OF JURISDICTION

Jurisdiction of this Court is invoked pursuant to 28 U.S.C. § 1254(1).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

This petition involves the interpretation of the United States patent reexamination statutes, 35 U.S.C. §§ 301-304.

35 U.S.C. § 301. Citation of prior art

> Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the

patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

35 U.S.C. § 302. Request for reexamination

Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title. The request must be in writing and must be accompanied by payment of a reexamination fee established by the Commissioner of Patents pursuant to the provisions of section 41 of this title. The request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. Unless the requesting person is the owner of the patent, the Commissioner promptly will send a copy of the request to the owner of record of the patent.

35 U.S.C. § 303. Determination of issue by Commissioner

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Commissioner will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

On his own initiative, and any time, the Commissioner may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title.

(b) A record of the Commissioner's determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.

(c) A determination by the Commissioner pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Commissioner may refund a portion of the reexamination fee required under section 302 of this title.

35 U.S.C. § 304. Reexamination order by Commissioner

If, in a determination made under the provisions of subsection 303(a) of this title, the Commissioner finds that a substantial new question of patentability affecting any claim of a patent is raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the

patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

STATEMENT OF THE CASE

Restorative Care of America Incorporated (Restorative Care) is the assignee from the inventor Robert Lonardo of U.S. patent 5,269,748 ('748), U.S. patent 5,298,013 ('013), and pending patent application serial number 08/218,756 ('756). Restorative Care is also the assignee of expired U.S. reissue patent 33,762 ('762). The '756 application, the '013 patent and '748 patent are all related in a chain of applications, and along with the unrelated '762 patent, all trace their roots back to the same abandoned patent application. The '748, '013, '762 patents and the '756 application all relate to a therapeutic leg and foot device, and have the same specification and drawings.

A. Patent Office Prosecution.

At the request of third parties, the '748 and '013 patents have undergone reexamination in the Patent Office. Reexamination of the '748 patent was ordered on the basis of the '762 patent, while reexamination of the '013 patent was ordered on the basis of a new question of patentability over the Baker patent. (App. 8a). The same Patent Office Examiner conducted the '748 and '013 reexaminations and the examination of the '756 pending application. Using the same rationale in all three cases (after confirming that Baker did not invalidate the '013 claims), the Examiner rejected the '748 and '013 claims

and the '756 claims on the basis of double patenting, citing the '762 reissue patent. With respect to the double patenting rejection of the '748 patent, the Examiner expressly stated

> It is clear that the "same invention" type double patenting was never contemplated. Applicant on pages 6-8 argues that an obvious-type rejection does not exist. Applicant is correct. The Examiner never argued obvious-type double patenting.

(App. 67a-68a). The Examiner's reasoning was the same for the double patenting rejection of the '748 and '013 patents and the '756 application. (App. 62a-73a, 74a-84a, 85a-94a, 95a-105a, 106a-116a). The Examiner's rationale is nearly identical to the 1996 Manual of Patent Examining Procedure Section 804(b)(2), page 800-20 entitled "Nonobvious Type" [double patenting]. (App. 148a-150a).

B. Patent Office Board of Appeals and Interferences.

The Patent Office Board of Appeals fully adopted the Examiner's reasoning for the double patenting rejections of the '748, '013 and '756 claims, stating, "the Examiner's conclusion of double patenting is sound." (App. 34a, 47a, 60a). However, despite the Examiner's admission that obvious-type double patenting does not exist, the Board called its affirmance of the Examiner's rejection "obvious-type" double patenting. (App. 30a, 41a, 53a).

C. The Federal Circuit Decision.

The Federal Circuit concluded that double patenting was a proper issue for reexamination, but refused to consider the non-obvious type double patenting rejection of the Examiner. In affirming the Board, the Federal Circuit stated that the Board

premised its affirmance of the Examiner on obviousness-type double patenting. (App. 14a). Thus, the Federal Circuit affirmed the Patent Office Board, which affirmed the Examiner, who rejected the claims on nonobviousness-type double patenting after concluding that obviousness-type double patenting did not exist. The Federal Circuit also declined to decide the pivotal issue on appeal of whether an Examiner can unilaterally develop a new question of patentability after the Commissioner has ordered reexamination only on a different question of patentability.

REASONS FOR GRANTING THE WRIT

I.

THE FEDERAL CIRCUIT ACTED CONTRARY TO THE CONGRESSIONAL INTENT OF THE PATENT REEXAMINATION STATUTE BY BROADENING THE SCOPE OF REEXAMINATION BEYOND PRIOR ART PATENTS AND PRINTED PUBLICATIONS TO INCLUDE DOUBLE PATENTING ISSUES.

The patent reexamination statute 35 U.S.C. §§ 301-307 was enacted in 1980, and became effective in 1981. The Supreme Court has never issued a decision concerning the reexamination statute. In the 16 years that the reexamination statute has been in force, 4,677 reexamination requests have been filed (through June 30, 1997), with 89% of the requests being granted. For the past five years (1992-1996), a total of 1,940 requests have been filed, for an average of 388 requests per year. For the first six months of 1997, 280 reexamination requests were filed. (App. 120a-121a). Forty two percent of all reexamination requests have been filed by the patent owner, while 56% of the requests have been filed by other members of the public. The Commissioner of the Patent and Trademark Office has initiated two percent of

reexaminations. Only 24% of patents reexamined survive with no changes to the claims, while 65% of reexamined patents result in claim changes, and 11% of reexamination patents terminate with all claims cancelled. (App. 120a-122a). Thus, the reexamination statute is of significant interest to patent owners, as well as third party requesters, such as accused infringers.

Here, the Federal Circuit opinion was a 2:1 split by the panel, with one judge dissenting on the basis that double patenting is not a ground permitted to be raised under the reexamination statute. (App. 19a-21a).

Therefore, the proper scope of reexamination is a timely and significant issue for this Court to review.

A. The Legislative History Of The Reexamination Statute.

As the Federal Circuit has recently reiterated,

> [T]he reexamination statute was an important part of a larger effort to revive the United States' competitive vitality by restoring confidence in the validity of patents issued by the PTO.

In re Recreative Technologies Corp., 83 F.3d 1394, 1396 (Fed. Cir. 1996). One of the major objectives of the reexamination statute was to strengthen investor confidence in the certainty of patent rights by creating a system of administrative reexamination of doubtful patents. House Report No. 96-1307, 96th Cong., 2d Sess. (1980), 3-4 *reprinted in 1980 U.S. Code Cong. & Ad. News*, 6460, 6462. (App. 128a). As stated in the House Report summary of the bill, the new reexamination procedure will permit any party to petition the Patent Office

> to review the efficacy of a patent, subsequent to its issuance, on the basis of new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application.

Id. (App. 130a).

35 U.S.C. § 301 provides, in part,

> Any person at any time may cite to the Office in writing *prior art* consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent.

(Emphasis added.)

Section 302 provides, in part,

> Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any *prior art* cited under the provisions of § 301 of this title.

(Emphasis added.)

Section 303(a) provides:

> (a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Commissioner will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications.

> On his own initiative, and any time, the Commissioner may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title.

B. The Issue: Can Double Patenting Be Considered During Reexamination?

As the Federal Circuit has explained in its *en banc* decision *In re Etter,* 756 F.2d 852, 856 (Fed. Cir. 1985), reexamination will

> permit any party to petition the Patent Office to review the efficacy of a patent, following its issuance, on the basis of new information about *preexisting* technology which may have escaped review at the time of the initial examination of the application.

Quoting the legislative history, House Report No. 96-1307 (emphasis added).

Here, the '762 patent which is the basis for the double patenting rejection of the '748 and '013 claims under reexamination, is *not* prior art.

The Patent Office and the Federal Circuit both rely upon § 303 which allows the Commissioner to consider "other patents and publications in determining whether a new question of patentability exists." The Patent Office and the Federal Circuit distinguish § 303 from §§ 301 and 302 which are limited to "prior art" patents and publications. However, while § 303 does not use the term "prior art," there is no basis in the legislative history to support the conclusion that the Commissioner may rely on non-prior art, and thereby consider double patenting upon

reexamination of a patent. This conclusion by the Federal Circuit is contrary to the legislative history, which clearly and unequivocally states that the new reexamination procedure is to allow review of a patent on the basis of new information about "preexisting technology". House Report 96-1307, *reprinted in 1980 U.S. Code Cong. and Ad. News*, 6460, 6462 (App. 130a).

Here, the '748 and '013 reexaminations were ordered based upon the requests of third parties. (App. 8a). Thus, these reexaminations clearly fall within § 302 of the reexamination statute, which requires that the reexamination be based upon prior art. However, the Federal Circuit states that under § 303(a), the Commissioner has authority on his own initiative to consider reexamination over patents and publications, without limitation to prior art patents or publications. (App. 12a). The Federal Circuit concluded:

> Since the statute in other places refers to prior art in relation to reexamination, *see id.*, it seems apparent that Congress intended that the phrase "patent and publications" and "other patents or printed publications" in § 303(a) not be limited to prior art patents or printed publications.

(App. 12a.)

This conclusion, however, is unsupported by the legislative history, which indicates that the purpose of reexamination is to consider "preexisting technology."

II.

THE FEDERAL CIRCUIT BREACHED ITS MANDATE OF PROVIDING CONSISTENCY IN THE PATENT LAWS BY IGNORING ITS OWN PRECEDENT, INCLUDING *EN BANC* DECISIONS, REGARDING THE SCOPE OF REEXAMINATION, THEREBY FRUSTRATING THE CONGRESSIONAL PURPOSE IN ESTABLISHING THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT.

The Federal Circuit's conclusion that the Commissioner can broaden reexamination beyond prior art patents and publications to consider non-prior art double patenting is inconsistent with its own precedent. For example, in *Etter,* the *en banc* court acknowledged that "patent claims are reexamined *only* in light of patents or printed publications under 35 U.S.C. §§ 102, 103." 756 F.2d at 856 (emphasis added).

Also, as the Federal Circuit explained in *In Recreative Technologies Corp.*, 83 F.3d 1394, 1397 (Fed. Cir. 1996),

> reexamination as enacted was carefully limited to new *prior art,* that is, "new information about pre-existing technology which may have escaped review at the time of the initial examination of the patent application. (Citing the legislative history). No grounds of reexamination were to be permitted other than based on new *prior art* and §§ 102 and 103.

(Emphasis added).

The Federal Circuit's conclusion in this case that the non-prior art '762 patent can be considered during reexamination for purposes of double patenting is inconsistent with its *en banc*

decision in *Etter*, its decision in *Recreative Technologies*, and the legislative history. This inconsistency with its own precedent frustrates the purpose and mandate of the Federal Circuit.

More particularly, as this Court recently explained in *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1396 (1996), Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases to provide uniformity in the patent laws. As the Federal Circuit discussed in *Panduit Corp. v. All States Plastic Manufacturing Co., Inc.*, 744 F.2d 1564, 1573 (Fed. Cir. 1984), the purpose of the Federal Circuit's enabling act, the Federal Court's Improvement Act of 1982, is to provide "a forum that will increase doctrinal stability in the field of patent law." As the Federal Circuit further explained,

> It is, therefore, clear that one of the primary objectives of our enabling legislation is to bring about uniformity in the area of patent law. "[T]he [central purpose of the FCAI] is to reduce the wide spread lack of uniformity and uncertainty of legal doctrine that exists in the administration of patent law." (Citing Legislative History). This court was created, as contemplated by the Congress, to achieve uniformity and to reduce uncertainties in this area. This court, thus, has a mandate to achieve uniformity in patent matters.

Panduit, id. at 1574.

The Federal Circuit now has frustrated its mandate and purpose of providing uniformity in the patent laws by contradicting its own precedent, including the *en banc* decision of *Etter* and *Recreative Technologies*, which previously held that reexamination was limited to prior art and to §§ 102 and 103. To the contrary, in the present case the Federal Circuit has

broadened reexamination to include non-prior art double patenting issues.

Therefore, this Court should grant the Writ of Certiorari so as to consider the scope of reexamination and so as to provide consistency in this aspect of the patent laws. Furthermore, this Court should conclude that consistent with the legislative history of the reexamination statute, reexamination is limited in all circumstances to consideration of prior art patents and printed publications, and that the Commissioner cannot broaden reexamination to include non-prior art patents. Accordingly, this Court should vacate the Federal Circuit's decision regarding the '748 and '013 patent reexaminations.

III.

THE FEDERAL CIRCUIT BREACHED ITS MANDATE OF PROVIDING CONSISTENCY IN THE PATENT LAWS BY IGNORING ITS OWN PRECEDENT, INCLUDING *EN BANC* DECISIONS, REGARDING THE SCOPE OF DOUBLE PATENTING, THEREBY FRUSTRATING THE CONGRESSIONAL PURPOSE IN ESTABLISHING THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT.

Since the Federal Circuit is the only Appellate Court for patent issues, and since the purpose of the Federal Circuit is to provide uniformity in the patent laws, inconsistencies among different Federal Circuit decisions and with the prior precedent of the C.C.P.A. need to be resolved by the Supreme Court.

The doctrine of double patenting is well established in the patent law, though the Supreme Court has not addressed the merits of this doctrine for over 100 years, since the decision in *Miller v. Eagle Manufacturing Co.*, 151 U.S. 186, 14 S. Ct. 310

(1894). The double patenting doctrine historically has two prongs: the statutorily based "same invention" type double patenting and the judicially created "obviousness type" double patenting.

More particularly, a restatement of the law of double patenting was set forth by the Court of Customs and Patent Appeals in *In re Vogel*, 422 F.2d 438, 441 (C.C.P.A. 1970).[1] As explained by the C.C.P.A. in *Vogel*, the determination of whether double patenting exists requires the analysis of two questions: First, is the same invention being claimed twice? If not, does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent; if the answer to the second question is "no", there is no double patenting. *Vogel*, 422 F.2d at 442.

Here, the only rejection from the Patent Office Examiner of the '748, '013 and '756 claims was a rejection for nonobviousness type double patenting. The Examiner unequivocally stated that obvious-type double patenting does not exist and that she never argued obvious-type double patenting. (App. 68a). The basis for rejection was the same in the '748 and '013 patents and the '756 application. (App. 62a-84a, 85a-94a, 95a-105a, 106a-116a.) The Examiner's rationale is nearly identical to the 1996 Manual of Patenting Examining Procedure, § 804(B)(2), page 800-20 entitled "Nonobvious Type." (App. 148a-150a).

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1. The Federal Circuit has adopted the decisions of the C.C.P.A. as binding precedent. *South Corp. v. United States*, 690 F.2d 1368, 1370 (Fed. Cir. 1982) *en banc*; *UMC Electronics Co. v. United States*, 816 F.2d 647, 652 n.6 (Fed. Cir. 1987). Since the C.C.P.A. always sat *en banc*, *In re Gosteli*, 872 F.2d 1008, 1011 (Fed. Cir. 1989), decisions of the C.C.P.A. can only be overruled by the Federal Circuit sitting *en banc*. *See Racing Strollers, Inc. v. TRI Industries, Inc.*, 878 F.2d 1418, 1420 (Fed. Cir. 1989); *Johnston v. IVAC Corp.*, 885 F.2d 1574, 1579 (Fed. Cir. 1989).

The Patent Office Board fully adopted the Examiner's reasoning for the double patenting rejections. (App. 34a, 47a, 60a). However, despite the Examiner's admission that obvious-type double patenting does not exist, the Board used the catch-all phrase "obvious type" double patenting.

Now, the Federal Circuit has refused to consider the propriety of the nonobvious-type double patenting rejection (App. 14a), but rather has affirmed an obvious-type double patenting rejection which was nonexistent in the Patent Office.

The concept of nonobvious-type double patenting is inconsistent with the established double patenting doctrine. More particularly, as the Federal Circuit has explained in *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 972 F.2d 1272, 1278 (Fed. Cir. 1992), since the two patents did not claim the same invention, nor did they claim merely obvious variations of one another under an obviousness-type double patenting analysis, there was no double patenting. The court unequivocally stated, "No other kind of 'double patenting' is recognized." *Id.*

The basis for both "same invention" and "obviousness type" of double patenting rejections is a time-wise extension of the patent right. *In re Kaplan*, 789 F.2d 1574, 1579 (Fed. Cir. 1986). All proper double patenting rejections rest upon the same invention or obviousness-type double patenting. *Id.* at 1579-80. If the claims of the application under consideration and the prior patent are not the same or obvious, then there is no double patenting. *General Foods*, 972 F.2d at 1278.

Before the establishment of the Federal Circuit, the C.C.P.A. recognized that, "There are three categories into which inventions may fall: Unobvious, Obvious, and Same Invention." *In re White*, 405 F.2d 904, 906 (C.C.P.A. 1969), citing *In re Eckle*, 393 F.2d 848, 856 (C.C.P.A. 1986). If the claimed

invention is nonobvious, there can be no double patenting. *White*, 405 F.2d at 906. It has never been contrary to patent law to have unobvious subject matter which, if patented, would overlap protection for previously claimed subject matter. *In re Braithwaite*, 379 F.2d 594, 602 n.3 (J. Smith concurring) (C.C.P.A. 1967).

If the application claim is more than an obvious variation of a patented claim, the claims are patentably distinct. *General Foods*, 972 F.2d at 1278. The term unobvious is equivalent to patentably distinct. *General Foods*, 972 F.2d at 1279.

Thus, the patent Examiner's assertion of a nonobvious-type of double patenting, with the rationale therefore being affirmed by the Board, and the Federal Circuit refusing to consider the issue, creates an inconsistency with long established precedent. Accordingly, the purpose of the Federal Circuit in creating uniformity in the patent laws is not being served.

Furthermore, the Federal Circuit's action in raising a new obvious-type double patenting rejection which was not considered by the Examiner is in violation of its own precedent. In particular, in *Recreative Technologies*, 83 F.3d at 1398-99, the Federal Circuit explained

> It cannot have been the statutory intent that a patentee would not know whether there was a new ground of rejection, as required for reexamination, until the reexamination was completed on the old ground, was appealed to the Board, and was decided by the Board not on the old ground but on a possibly new ground that was not previously part of the reexamination. . . . It would eviscerate the statutory safeguard to permit the Board to cure an improper reexamination with the creation of a new issue at the appellate stage of the reexamination proceeding.

Contrary to this clear explanation of the reexamination legislative history, the Federal Circuit here has raised the new issue of obvious-type double patenting, in violation of the legislative intent of the reexamination statute. Thus, the Federal Circuit's decision in the present case is inconsistent with both the statutory intent and its own precedent.[2]

Thus, in view of the inconsistencies now raised by the Patent Office and the Federal Circuit on the doctrine of double patenting, this Court should renew and reestablish its 1894 decision of *Miller v. Eagle Manufacturing* so as to provide consistency in this area of the patent law, which the Federal Circuit has failed to do in accordance with its purpose and mandate.

IV.

BY FAILING TO DECIDE THE ISSUE OF WHETHER REEXAMINATION CAN BE BROADENED BEYOND THE NEW QUESTION OF PATENTABILITY SET FORTH IN THE REEXAMINATION ORDER UNDER 35 U.S.C. § 304, THE FEDERAL CIRCUIT HAS IGNORED THE STATUTORY MANDATE, THEREBY IMPLICITLY AUTHORIZING THE PATENT OFFICE TO ACT CONTRARY TO THE CONGRESSIONAL INTENT OF THE REEXAMINATION STATUTE.

The refusal of the Federal Circuit to decide the pivotal issue on appeal of whether an Examiner can unilaterally develop a new question of patentability not included in the order of reexamination will potentially affect every reexamination in the future, as it has affected many in the past.

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2. Prior decisions of a Federal Circuit panel are binding on subsequent panels. *Newell Companies, Inc. v. Kenney Manufacturing Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988).

The reexamination order pertaining to the '013 patent was based on the substantial new question of patentability of the '013 patent claims over a prior art patent to Baker (App. 15a). During reexamination, the patent Examiner did not reject the '013 claims based on the Baker patent (App. 82a), but rejected the '013 claims on a *new* issue of double patenting. The Patent Office Board affirmed the Examiner's rejection. The Federal Circuit was asked by Petitioners to reverse this decision, in part, because the reexamination statutes do not permit the Examiner to decide any issue other than the question of patentability specifically set forth in the reexamination order. (35 U.S.C. § 304). The Federal Circuit did not decide this issue which was squarely before the Court on appeal. A favorable decision on this issue for Petitioners would have changed completely the outcome of the Court's decision on the '013 patent. Petitioners again requested the Federal Circuit to decide this issue in Petitioner's petition for rehearing or rehearing *en banc*, and the Court declined to do so without comment.

Since the Federal Circuit is the only Appellate Court for patent issues, and since the critical issue of the impropriety of an Examiner unilaterally changing the previously issued order of reexamination was a pivotal question on appeal, and since this issue potentially affects every reexamination in the future, the failure of the Federal Circuit to decide this important question mandates that a Writ of Certiorari be granted to permit this pivotal question to be decided, or to permit it to be remanded to the Federal Circuit for decision.

35 U.S.C. § 304 provides, in part,

> If, in a determination made under the provisions of subsection 303(a) of this title, the Commissioner finds that a substantial new question of patentability affecting any claim of a patent is raised, the

> determination will include an order for reexamination of the patent for resolution of the question.

Thus, the issue arises as to whether reexamination can be broadened beyond the new question of patentability set forth in the reexamination order, so as to consider different questions of patentability.

The Federal Circuit has failed to distinguish the rights of the Commissioner to develop additional substantial new questions of patentability under 35 U.S.C. § 303 with the requirements of § 304. Once the reexamination order is issued under § 304, "the question" of patentability must then be decided. There is no right for the Patent Office to expand the order to additional or different questions of patentability *after* the reexamination order has been issued under § 304. Thus, while the Patent Office Commissioner may consider prior art other than that presented in a reexamination request, such additional prior art must be considered *before* the reexamination order is issued under § 304. There is no statutory authority which allows the Patent Office to expand the order of reexamination to introduce new questions of patentability *after* the order has issued. This practice of the Patent Office is contrary to law.

As indicated, the reexamination order for the '013 patent was premised solely upon a new question of patentability in view of the Baker patent. (App. 8a). After determining that the Baker patent did not invalidate the '013 claims, the PTO went beyond the reexamination order and rejected the '013 claims on the basis of double patenting.

As the *en banc* court decided in *Etter*, the Patent Office "should not merely allow reexamination to proceed in any direction at the discretion of an examiner." 756 F.2d at 856. Patentability of the claims is not to be considered *de novo* during

reexamination. *Id.* at 756 F.2d at 861 (concurring opinion). Rather, the claims are to be reexamined in light of the art cited in the § 304 reexamination order. *Id.*, 756 F.2d at 857.

The scope of reexamination is an important issue for all patentees. Thus, the Federal Circuit's failure to consider whether the scope of reexamination can be broadened to consider patentability issues beyond those set in the reexamination order raises a significant procedural question which should be clarified by the Supreme Court, so as provide consistency with the statute and with Federal Circuit precedent.

V.

THE FEDERAL CIRCUIT HAS BREACHED ITS MANDATE BY FAILING TO PROVIDE CONSISTENCY IN CLAIM CONSTRUCTION GUIDELINES, PARTICULARLY FOR MEANS PLUS FUNCTION CLAUSES UNDER SECTION 112(6).

A related issue in this case is claim construction. Uniformity of the patent laws, including claim construction, was the goal of Congress in creating the Court of Appeals for the Federal Circuit, with the resulting benefit that such increased uniformity would "strengthen the United States patent system in such a way as to foster technological growth and industrial innovation." *Markman v. Westview Instruments, Inc.*, 116 S. Ct. 1384, 1396 (1996).

In interpreting a "means plus function" claim limitation, one must look to the specification, in accordance with *In re Donaldson Co., Inc.*, 16 F.3d 1189, 1192-93 (Fed. Cir. 1994) (*en banc*). However, the question that needs clarification from this court is how much of the specification is applied or read into the claims for such a means plus function clause.

The Federal Circuit has repeatedly stated that interpretation of a claim in light of the specification does not mean that everything in the specification must be read into the claim. *SRI International v. Matsushita Electric Corp. of America*, 775 F.2d 1107, 1121 (Fed. Cir. 1985) (*en banc*); *Etter*, 756 F.2d at 858; *Donaldson*, 16 F.3d at 1195. As the Federal Circuit explained in *E.I. Du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988), using the specification to interpret a phrase in a claim is not to be confused with adding an extraneous limitation from the specification, which is improper. Where a specification does not *require* a limitation, the limitation should not be read from the specification into the claim. *Id.* (emphasis in the original).

As further explained by the Federal Circuit

> It is settled law that when a patent claim does not contain a certain limitation and another claim does, that limitation cannot be read into the former claim in determining either validity or infringement.

SRI, 775 F.2d at 1122. Here, the Federal Circuit has concluded that the "means for releasably securing" clause of the '762 claim 1 and '748 claim 9 includes a sandal with a cut-out heel portion. (Lodging App. Q, R). However, this interpretation ignores the Federal Circuit caution that not everything in the specification must be read into the claim. The relevant portion of the '762 specification is set forth at column 3, lines 55-column 4, line 2, which provides:

> Any suitable means may be used to secure the device to the leg and foot of the patient. For example, viewing FIGS. 8 and 9, I use a soft leather sleeve or sandal 30 which is slipped over the patient's foot and the foot portion 21 of the device. It is provided with a cut out

> heel portion with strips 31 and 32 passing under the foot and strips 33 behind the upper heel. The front is provided with a flap 34 having any suitable fastening means such as the Velcro fastener 35, for securement around the instep. An additional strip 36, provided with a Velcro fastener 37, extends above the ankle region. In addition to the sandal 30, the leg portion 20 is provided with slots 38 adjacent the rear upper end. A strip 39 extends around the leg through the slots 38 to complete the mounting of the device.

(Lodging App. Q).

The cut out heel serves no securing function. Therefore, so as to be consistent with the Federal Circuit precedent, in interpreting the "means for securing" clause, it is unnecessary to go beyond the second sentence of the above quoted specification (I use a soft leather sleeve or sandal 30 which is slipped over the patient's foot and the foot portion 21 of the device.")

The "cut out heel portion" of the '748 claim 9, the "cutting out" step of the '013 claims, and the "providing an opening" step in the '756 claim cannot be ignored or read out of the claims. To interpret "means for securing" to include the cut-out heel portion of the sandal as part of the "securing means" or "securing steps" of the '748, '013 and '756 claims, in effect leaves no meaning for the additional claim elements or steps ('748 cut out heel portion; '013 cutting out step; and '756 providing an opening step). (Lodging App. R, S, T).

Thus, the interpretation of the "means for securing" clause by the Board and the Federal Circuit impermissibly reads unnecessary limitations from the specification into the claims, all in contradiction to the Federal Circuit's *en banc* precedents of *SRI* and *Donaldson*, as well as *Du Pont*.

CONCLUSION

This Court has never issued a decision regarding the patent reexamination statute, and has not considered the merits of double patenting in over a century. Also, the Federal Circuit has refused to decide an issue on appeal as to allowing an Examiner to develop questions of patentability not in the reexamination order, which could have changed the outcome of the decision below as to the '013 patent, and which will potentially bear on all reexaminations of the future. Thus, so as to provide consistency in the patent laws regarding reexamination, double patenting, whether only the reexamination order governs the reexamination process, and claim interpretation, a Writ of Certiorari should issue to review the judgment, and the issues raised thereby, of the United States Court of Appeals for the Federal Circuit.

Respectfully submitted,

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APPENDIX A — DECISION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DECIDED JULY 8, 1997

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

96-1101,-1123,-1124
(Serial No. 08/218,756)
IN RE ROBERT LONARDO

(Reexamination No. 90/003,494)
IN RE RESTORATIVE CARE

(Reexamination No. 90/003,343)
IN RE RESTORATIVE CARE

Kirk M. Hartung, Zarley, McKee, Thomte, Voorhees & Sease, of Des Moines, Iowa, argued for appellants. With him on the brief was *Donald H. Zarley*.

Nancy J. Linck, Solicitor, U.S. Patent and Trademark Office, of Arlington, Virginia, argued for the Commissioner. With her on the brief were *Albin F. Drost*, Deputy Solicitor, *Joseph G. Piccolo* and *John M. Whealan*, Associate Solicitors.

Appealed from: U.S. Patent and Trademark Office
Board of Patent Appeals and Interferences

Appendix A

United States Court of Appeals for the Federal Circuit

96-1101,-1123,-1124
(Serial No. 08/218,756)
IN RE ROBERT LONARDO

(Reexamination No. 90/003,494)
IN RE RESTORATIVE CARE

(Reexamination No. 90/003,343)
IN RE RESTORATIVE CARE

DECIDED: July 8, 1997

Before NEWMAN, LOURIE, and RADER, *Circuit Judges*.

Opinion for the court filed by *Circuit Judge* LOURIE. Opinion concurring in the judgment as to Serial No. 08/218,756 and dissenting as to Reexamination Nos. 98/003,494 and 90/003,343 filed by *Circuit Judge* NEWMAN.

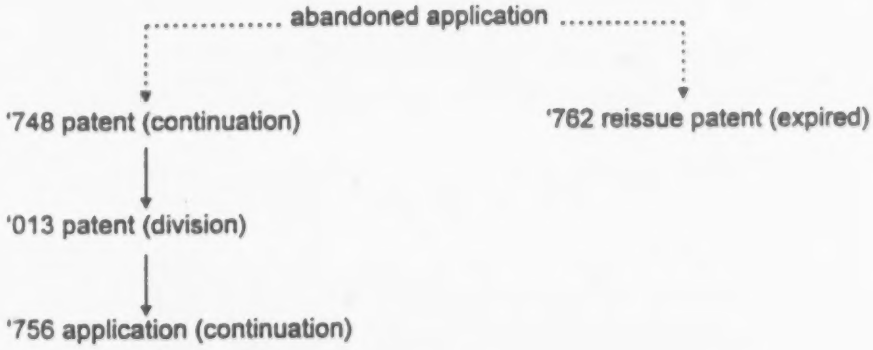
LOURIE, *Circuit Judge*.

Robert Lonardo and Restorative Care of America Inc. appeal from three decisions of the Patent and Trademark Office (PTO) Board of Patent Appeals and Interferences holding that certain claims of U.S. Patents 5,269,748 and 5,298,013 are invalid, and that the only claim of application S/N 08/218,756 is not allowable, based on the ground of double patenting over expired U.S. Patent Re. 33,762. *Ex parte Restorative Care of Am., Inc.*, No. 95-4499 (Bd. Pat. App. & Int. Oct. 13, 1995); *Ex parte Restorative Care of Am., Inc.*, No. 95-4500 (Bd. Pat. App. & Int. Oct. 13, 1995); *Ex parte Lonardo*, No. 95-4476 (Bd. Pat.

App. & Int. Oct. 13, 1995). Because the board did not err in holding that the rejected claims of the patents are unpatentable and that the claim of the application is not allowable, we affirm.

BACKGROUND

The '756 application is a continuation of the application that issued as the '013 patent, which is a division of the application that issued as the '748 patent. The '013 and '748 patents, the '756 application, and the '762 patent are all apparently entitled to the benefit of the filing date of the same abandoned application. The following chart indicates the relationship between these patents and applications.



The inventions of the patents and application generally concern a therapeutic leg and foot device. As shown in figure 8 of the application and patents, reproduced below, this device includes an L-shaped member having a leg portion (20), a heel portion (22) at the end of the leg portion, and a foot portion (21) extending from the heel portion at a right angle to the leg portion. The heel portion is configured to provide a space (27) between a patient's heel and the heel portion (22) in order to prevent the application of pressure to the patient's heel. This is useful, for

example, in preventing the formation of a decubitus ulcer (pressure sore) on the heel of a bedridden patient.

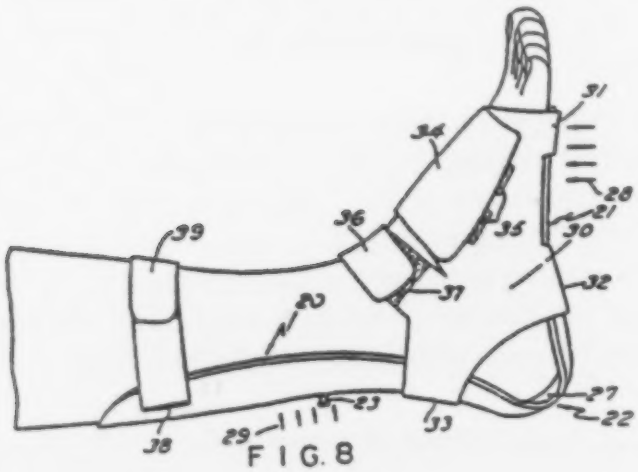


FIG. 8

Claim 1 of the expired '762 reissue patent reads as follows:

> 1. A therapeutic leg and foot device comprising an L-shaped member of a flexible, transparent, acrylic, plastic, said member having a generally contoured and channel-shaped leg portion, a curved heel portion integral with one end of said leg portion, and a generally contoured foot portion extending integrally from said heel portion at right angles to said leg portion, said foot portion being shorter than the adult human foot, the channel shape of said leg portion being substantially flattened at said heel portion, said curved heel portion being narrower than said foot and leg portions and having a free and unflanged edge to permit

Appendix A

flexing of said foot portion with respect to said leg portion, said foot portion exerting a pressure of 30 to 50 lbs. toward said leg portion when said foot portion is flexed away from the right angle position, and means for releasably securing the device to the leg and foot of a patient.

The '748 patent also claims a device, claims 1 and 9 reading as follows:

1. A therapeutic leg and foot device, comprising, an L-shaped member comprised of a one piece flexible plastic material;

said L-shaped member having a leg portion, a heel portion integral with one end of said leg portion, and a foot portion extending integrally from said heel portion at right angles to said leg portion,

said heel portion having a configuration to provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by the heel portion when the posterior region of the lower leg and the sole of the foot of a patient wearing the device are in supporting contact with said leg portion and said foot portion, respectively, resulting from the configuration of said heel portion,

said heel portion having substantially free and unflanged side edges to permit lateral

visibility of said space and a patient's heel suspended within said space, and

means for releasably securing said device to the leg and foot of a patient.

9. The device of claim 1 wherein said means for releasably securing said device to the leg and the foot of a patient is comprised of a sandal extending substantially over said foot portion and the foot of the patient with a cut out heel portion adjacent said heel portion of said splint and said space.

Restorative Care stated in its brief that claim 11 "is substantially similar to claim 9, except there is no limitation in claim 10 (from which claim 11 depends) that the L-shaped member be a one piece plastic material (as in claim 1 from which claim 9 depends)."

The '013 patent claims a method, claim 1 reading as follows:

1. The method of healing or preventing decubitus on the heel of a bedfast patient, comprising,

placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion on one end of said leg portion, and a foot portion extending from said heel portion at right angles to said leg portion,

forming the shape of said heel portion so that the shape alone of said heel portion will

provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respective,

and securing said L-shaped member to the leg and foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and cutting out a heel portion of said sandal adjacent said heel portion of said L-shaped member and said space.

The '756 application also claims a method, claim 1 reading as follows:

1. The method of healing or preventing decubitus on the heel of a bedfast patient, comprising,

placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion secured to one end of said leg portion, and a foot portion extending from said heel portion substantially at right angles to said leg portion,

forming the shape of said heel portion so that the shape alone of said heel portion alone will provide a space between the heel portion

and said heel of said patient to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respectively,

securing said L-shaped member to the leg and foot of said patient by using a sandal extending substantially over said foot portion, and the foot of the patient,

and providing an opening in said sandal adjacent said heel portion of said L-shaped member and said space to permit visual inspection of said space from a lateral direction.

Third parties requested reexamination of the '748 and '013 patents; the reexaminations were limited to claims 9 and 11 of the '748 patent and claims 1, 2, and 5 of the '013 patent. The reexamination order for the '748 patent was based on a new question of patentability allegedly raised with respect to the '762 patent, and the reexamination order for the '013 patent was based on a new question of patentability allegedly raised with respect to another patent. During reexamination, the claims in question of both patents were rejected on the ground of double patenting over claim 1 of the '762 patent. Restorative Care appealed to the board, arguing that double patenting was improperly raised during reexamination and that the claims in question are patentably distinct over claim 1 of the '762 patent.

The board first determined that the issue of double patenting was properly raised during reexamination of the '748 patent. It

reasoned that under 35 U.S.C. § 303 (1994), the Commissioner has the authority to consider "other patents" during reexamination, aside from "prior art consisting of patents or printed publications" specified in 35 U.S.C. § 301 (1994). The board in effect interpreted the phrase "other patents" in section 303 as not being limited to prior art patents. It affirmed the rejection of claims 9 and 11 of the '748 patent on the ground of obviousness-type double patenting over claim 1 of the '762 patent. The board reasoned that obviousness-type double patenting includes all types of double patenting other than "same invention" double patenting. Since the claims in question did not define identical subject matter, the board held that "same invention" double patenting did not apply, but obviousness-type double patenting was properly applied because one could not practice the invention of the expired '762 patent without infringing the '748 patent.

The board's analysis next focused on the "securing" means limitation of claims 9 and 11. In construing that limitation under 35 U.S.C. § 112, ¶ 6 (1994), the board found that the only structure disclosed for that means was a sandal with a cut-out heel portion. The board thus concluded that the claims of the '762 and '748 patents both require that structure and accordingly that they are not patentably distinct. The board also affirmed the rejection of claims 1, 2, and 5 of the '013 patent on the ground of double patenting over claim 1 of the '762 patent. The board found that the "securing" step requires securing a sandal with a cut-out heel portion and again interpreted the "securing" means of the '762 patent claim as requiring a sandal with a cut-out heel portion. The board therefore concluded that the method of the '013 patent is not patentably distinct from the apparatus of the '762 patent.

Finally, the sole claim of the '756 application was rejected on the ground of double patenting over claim 1 of the '762 patent. The board found that the claimed method of the '756 application requires use of a sandal with a cut-out heel portion. Because the apparatus of the '762 patent requires that same structure, the board concluded that the method was not patentably distinct over the apparatus.

Lonardo and Restorative Care appealed to this court and all three cases were consolidated for appeal. We have jurisdiction pursuant to 28 U.S.C. § 1295(a)(4) (1994). Double patenting is a question of law that we review *de novo*. *Texas Instruments v. United States Int'l Trade Comm'n*, 998 F.2d 1165, 1179, 26 USPQ2d 1018, 1029 (Fed. Cir. 1993).

DISCUSSION

A. *Propriety of Reexamination*

Restorative Care argues that there was no basis for reexamination of the '748 patent, that reexamination may only be ordered to decide new questions of patentability based upon prior art. Because the '762 and '748 patents are entitled to the same filing date, Restorative Care argues, the '762 patent is not prior art to the '748 patent and the reexamination thus was improper. The PTO responds that the Commissioner is authorized to consider double patenting during reexamination. In particular, the PTO argues that the reexamination statute authorizes the Commissioner to consider "other patents or printed publications" without restriction to prior art. The PTO also argues that, because obviousness-type double patenting is judicially-created and is not based upon statute, there is no statutory reason why it may not be applied in both examination and reexamination.

Appendix A

The doctrine of double patenting is intended to prevent a patentee from obtaining a time-wise extension of patent for the same invention or an obvious modification thereof. *E.g.*, *In re Longi*, 759 F.2d 887, 892, 225 USPQ 645, 648 (Fed. Cir. 1985). "Same invention" double patenting is based upon 35 U.S.C. § 101 (1994), which states that an inventor may obtain "a patent" for an invention. The statute thus permits only one patent to be obtained for a single invention, and the phrase "same invention" refers to an invention drawn to substantially identical subject matter. *Id.* Obviousness-type double patenting, on the other hand, is judicially created and prohibits an inventor from obtaining a second patent for claims that are not patentably distinct from the claims of the first patent. *Id.* With obviousness-type double patenting, however, a terminal disclaimer may overcome that basis for unpatentability, assuming that the first patent has not expired. In this case, the '762 patent, over which the claims have been rejected, has expired, so a terminal disclaimer cannot cure these rejections.

The applicable statute relating to reexamination provides that:

> Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Commissioner will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Commissioner may determine whether a substantial new question of

> patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title.

35 U.S.C. § 303(a) (1994).

Under section 303(a), the Commissioner has authority "[o]n his own initiative" to consider a substantial new question of patentability over "patents and publications discovered by him." That provision of the statute is not specifically limited to prior art patents or printed publications. Moreover, it authorizes the Commissioner to consider "other patents or printed publications" in addition to the prior art submitted by a third party who may have requested the reexamination. *See* 35 U.S.C. § 301 (1994) ("Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent."); 35 U.S.C. § 302 (1994) ("Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title."). Since the statute in other places refers to prior art in relation to reexamination, *see id.*, it seems apparent that Congress intended that the phrases "patents and publications" and "other patents or printed publications" in section 303(a) not be limited to prior art patents or printed publications.

The legislative history indicates that considerations such as cost and availability of evidence were among the criteria Congress considered in determining the scope of reexamination. *See* H.R. Rep. No. 1307, at 4 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6462-63; *see also Quad Envtl. Techs. Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 875 n.7, 20 USPQ2d 1392,

1395 n.7 (Fed. Cir. 1991) (stating that the purpose in restricting reexamination to printed documents "was to provide a cheaper and less time-consuming alternative way to challenge patent validity on certain issues"). A patent is clearly the type of evidence that Congress intended the PTO to consider during reexamination, and the cost of examination is not significantly increased by having the PTO consider the ground of double patenting, as it involves issues of claim identity and obviousness, well within the PTO's everyday expertise. The burdens on the patentee and the PTO are the same, whether the issue is novelty or nonobviousness over prior art patents or double patenting over a prior-issued patent. Moreover, the efficiency of the patent evaluation process is ultimately increased by allowing the PTO to consider double patenting during reexamination, rather than requiring a district court to decide a challenge to a patent based upon alleged double patenting. Finally, it is reasonable to conclude that Congress intended to include double patenting over a prior patent as a basis for reexamination because maintenance of a patent that creates double patenting is as much of an imposition on the public as maintenance of a patent that is unpatentable over prior art. Thus, we conclude that the PTO was authorized during reexamination to consider the question of double patenting based upon the '762 patent.

Restorative Care also argues that, even if the PTO was entitled to consider double patenting during reexamination, the examiner improperly relied upon a "nonobvious double patenting" ground. It refers to the examiner's reasoning that the patentee should not be entitled to maintenance of the rejected claims because it did not show why the claims were not presented in the earlier patent and the subject matter of the claims was fully disclosed in that patent. Restorative Care argues that there are only two types of double patenting, same invention and

obviousness-type, and that the board improperly affirmed the rejection based upon a nonexistent class of double patenting. The PTO responds that the board properly relied upon obviousness-type double patenting by finding that the '748, '013, and '762 claims are only obvious variations of each other.

We note that the Manual of Patent Examining Procedure contains a section entitled "Nonobvious Type" within its discussion of nonstatutory double patenting. M.P.E.P. § 804(B)(2), p. 800-20 (July 1996). It refers to the questions whether claims could have been presented in an earlier patent and whether the subject matter is disclosed in that patent. Both issues were mentioned by the board here. However, we need not consider whether Restorative Care is correct in its assertion that its claims were improperly rejected on the basis of a nonobvious double patenting ground. The board premised its affirmance of the examiner on obviousness-type double patenting and we agree with its holding, as is indicated hereinbelow.

B. *Obviousness-Type Double Patenting*

1. *The '748 Patent*

Restorative Care argues that claims 9 and 11 of the '748 patent are patentably distinct from claim 1 of the '762 patent and that, accordingly, obviousness-type double patenting does not bar confirmation of its claims. In particular, it argues in its brief (emphasis in original) that, although all claims in question "require an L-shaped member with a leg portion, a heel portion, and a foot portion integral with one another," claim 1 of the '762 patent

> further requires that the L-shaped member be made from *transparent acrylic plastic*, that the foot and leg portions be *contoured*, that the foot portion be *shorter* than the adult human foot, that the leg portion be substantially *flattened* at the heel portion, that the heel portion be *narrower* than the leg and foot portions, and that the foot portion exert a pressure of *30-50* pounds.

The PTO responds that claims 9 and 11 of the '748 patent contain only obvious variations over claim 1 of the '762 patent and that one could not practice the invention of claim 1 of the '762 patent without also infringing claims 9 and 11.

We agree with the PTO that the claims in question are unpatentable on the ground of obviousness-type double patenting, not because one could not practice the invention of the '762 patent without infringing claims 9 and 10, but because each of the additional limitations argued by Restorative Care is an obvious modification of the device defined in the '762 claim. Many of the alleged differences in elements are in species-genus form, the expired '762 patent claiming an element with specificity and the '748 claims defining it more generically. For example, Restorative Care has shown no patentable distinction between a "leg portion" ('748 patent) and a "generally contoured and channel-shaped leg portion" ('762 patent), between a "foot portion" and a "generally contoured foot portion," or between a "heel portion" and a "curved heel portion."

Restorative Care also argues that the board improperly read limitations into the specification when it interpreted the "securing" means limitation of the '762 patent claim. The PTO

responds that, under 35 U.S.C. § 112, ¶ 6 (1994), the board correctly considered the specification in construing the "securing" means element. *See In re Donaldson*, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994) (in banc) (stating that section 112, ¶ 6, "applies regardless of the context in which the interpretation of means-plus-function language arises"). We agree with the PTO that the board correctly interpreted the "securing" means element under section 112, ¶ 6, and *Donaldson*. The only structure disclosed for implementing the function of the "securing" means is a sandal with a cut-out heel portion. In particular, the specification states that:

> Any suitable means may be used to secure the device to the leg and foot of the patient. For example, viewing FIGS. 8 and 9, I use a soft leather sleeve or sandal 30 which is slipped over the patient's foot and the foot portion 21 of the device. It is provided with a cut out heel portion with strips 31 and 32 passing under the foot and strips 33 behind the upper heel.

'762 patent, col. 3, lines 55-62. In interpreting the "securing" means in light of the disclosed structure, we do not disagree with the board that it must be interpreted in the manner that is expressly recited in claim 9 of the '748 patent. Accordingly, the board did not err in concluding that claims 9 and 11 of the '748 patent are unpatentable on that ground.

2. *The '013 Patent*

Restorative Care makes the same arguments with respect to this patent. For the reasons explained above, double patenting

was properly raised during reexamination of the '013 patent. Furthermore, the board correctly characterized the rejection as being based on obviousness-type double patenting.

Restorative Care argues that the claims in question are patentably distinct from the claims of the '762 patent. Restorative Care argues that the method of using the device would not have been obvious over a claim to the device. We do not agree that there is a patentable distinction between the method of using the device and the device itself. The claimed structure of the device suggests how it is to be used and that use thus would have been obvious.

Restorative Care also argues that the particular structure used by the method is patentably distinct from the device, and it makes essentially the same arguments with respect to the alleged structural differences as it did for the '748 patent. For the reasons explained above, we agree with the PTO that, even given these structural differences, the method would have been obvious. Accordingly, we conclude that the board did not err in holding that claims 1, 2, and 5 of the '013 patent are unpatentable on the ground of double patenting over the '762 patent.

3. *The '756 Application*

Lonardo finally argues that the claim of the '756 application is patentably distinct from the '762 patent claim. The PTO responds that the board correctly rejected the claim on the ground of obviousness-type double patenting. Lonardo makes essentially the same arguments with respect to the alleged distinctions between the method and device, and between the structure used by the method and the structure of the device, that Restorative Care made with respect to the '748 and '013

patents. For the reasons explained above, we do not agree that these are nonobvious distinctions or that there is such a distinction between the method of using the device and the device itself. Accordingly, we conclude that the board did not err in holding that the claim of the '756 application is unpatentable over the '762 patent on the ground of double patenting.

CONCLUSION

The board did not err in concluding that double patenting was properly raised during reexamination of the '748 and '013 patents and that claims 9 and 11 of the '748 patent and claims 1, 2, and 5 of the '013 patent are unpatentable over the '762 patent on the ground of obviousness-type double patenting. The board also did not err in concluding that claim 1 of the '756 application is not allowable on that same ground.

AFFIRMED

Appendix A

United States Court of Appeals for the Federal Circuit

96-1101, -1123, -1124

(Serial No. 08/218,756)
IN RE ROBERT LONARDO

(Reexamination No. 98/003,494)
IN RE RESTORATIVE CARE

(Reexamination No. 90/003,343)
IN RE RESTORATIVE CARE

NEWMAN, *Circuit Judge*, concurring in the judgment as to Serial No. 08/218,756, dissenting as to Reexamination Nos. 98/003,494 and 90/003,343.

Double patenting is not a ground of rejection that is permitted to be raised under the reexamination statute. I must, respectfully, dissent from the panel majority's decision to ignore the statutory limitations of reexamination.

The reexamination statute is the result of a carefully designed compromise, balancing the advantages of resolution of certain important issues by reexamination in the Patent and Trademark Office, against the disadvantages of potential harassment of patentees after their patent has issued. For this reason, the statute requires that reexamination be limited to "prior art consisting of patents or printed publications" cited to the Office under 35 U.S.C. §301. Section 302 authorizes a request for reexamination "on the basis of any prior art cited under the provisions of section 301," and states that the request "must set forth the pertinency and manner of applying cited prior

art." Patentability based on prior art is the only available ground of reexamination.[1]

Double patenting is not based on prior art. *See, e.g., Quad Environmental Tech. Corp. v. Union Sanitary Dist.*, 946 F.2d 870, 874, 20 USPQ2d 1392, 1394 (Fed. Cir. 1991) (a double patenting rejection "does not mean that the first-filed patent is a prior art reference under §102 against the later-filed application. [Citation omitted.]"); *In re Kaplan*, 789 F.2d 1574, 1579, 229 USPQ 678, 682 (Fed. Cir. 1986) ("In considering the question [of obviousness-type double patenting], the patent disclosure may not be used as prior art. [Citation omitted.]"); *In re Longi*, 759 F.2d 887, 892 n.4, 225 USPQ 645, 648 n.4 (Fed. Cir. 1985) ("the patent principally underlying the double patenting rejection is not considered prior art. [Citation omitted.]").

Limitation of reexamination to prior art was the legislative response to concerns lest the life of an issued patent be wasted and the patentee's legitimate rights be abused by third party requests for reexamination, for there are myriad grounds on which patentability is subject to challenge. *See Patlex Corp. v. Mossinghoff*, 758 F.2d 594, 601, 225 USPQ 243, 248 (Fed. Cir. 1985). In *In re Recreative Technologies Corp.*, 83 F.3d 1394, 1397, 38 USPQ2d 1776, 1778 (Fed. Cir. 1996) this court reviewed the legislative history and its "serious concern that reexamination not create new opportunities for abusive tactics and burdensome procedures." The requirement that "[n]o grounds of reexamination were to be permitted other than on

1. The panel majority's suggestion that the Commissioner's authority to act "on his own initiative," 35 U.S.C. §303(a), somehow enlarges the grounds of reexamination is not a tenable reading of the statute.

new prior art and sections 102 and 103" was a well-considered balance of the arguments for and against reexamination. H.R. Rep. No. 96-1307, at 3 (1980), *reprinted in* 1980 U.S.C.C.A.N. 6460, 6462 (reexamination is limited to new prior art).

The court again explained in *In re Portola Packaging, Inc.*, 110 F.3d 786, 789, 42 USPQ2d 1295, 1298 (Fed. Cir. 1997) that "Congress recognized that holdings of patent invalidity by courts were mostly based on prior art that was not before the PTO." (Citing *Patent Reexamination: Hearings on S.1679 before the Senate Comm. on the Judiciary*, 96th Cong. 14 (1980) (testimony of Commissioner Sidney Diamond) (referring to a 1974 study showing that 66-80% of the patents held invalid involved uncited prior art)). *See In re Etter*, 756 F.2d 852, 856, 225 USPQ 1, 4 (Fed. Cir. 1985) (*in banc*) (the purpose of reexamination is to remedy overlooked prior art).

To achieve a contrary holding for the ground of double patenting, my colleagues invoke "efficiency" and offer the explanation that reexamination is cheaper and less burdensome than litigation. However, these were not the only issues weighed and balanced in this legislation, for a primary concern was the encumbrance on the patent during reexamination proceedings. Indeed, here it is the patentee who is objecting to having been brought into involuntary reexamination by third parties while the patents are in litigation.

It is not our role to amend the statute, and it is not our privilege to ignore the statute. Indeed, I take note that Congress has recently held hearings on certain proposals to enlarge the scope of reexamination. Meanwhile, the statute continues to bar reexamination on the ground of double patenting.

APPENDIX B — JUDGMENT OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DATED JULY 8, 1997

United States Court of Appeals for the Federal Circuit

96-1101,-1123,-1124

(Serial No. 08/218,756)
IN RE ROBERT LONARDO

(Reexamination No. 90/003,494)
IN RE RESTORATIVE CARE

(Reexamination No. 90/003,343)
IN RE RESTORATIVE CARE

JUDGMENT

ON APPEAL from the UNITED STATES PATENT AND TRADEMARK OFFICE BOARD OF PATENT APPEALS AND INTERFERENCES

in Case NO(S). 08/218/756, 90/003,494, 90/003/343

This CAUSE having been heard and considered, it is

ORDERED and ADJUDGED:

AFFIRMED

ENTERED BY ORDER OF THE COURT

DATED JUL 08 1997

s/ Jan Horbaly
Jan Horbaly, Clerk

ISSUED AS A MANDATE: September 5, 1997

APPENDIX C — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING FILED AUGUST 29, 1997

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

96-1101,-1123,-1124

(Serial No. 08/218,756)
IN RE ROBERT LONARDO

(Reexamination No. 90/003,494)
IN RE RESTORATIVE CARE

(Reexamination No. 90/003,343)
IN RE RESTORATIVE CARE

ORDER

Appendix C

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

ORDER

A combined petition for rehearing and suggestion for rehearing in banc having been filed by the APPELLANT, and a response thereto having been invited by the court and filed by the APPELLEE, and the petition for rehearing having been referred to the panel that heard the appeal, and thereafter the suggestion for rehearing in banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the suggestion for rehearing in banc be, and the same hereby is, DECLINED.

The mandate of the court will issue on September 5, 1997.

FOR THE COURT,
JAN HORBALY, CLERK

Dated: August 29, 1997

By s/ Alex Van Veen
Alex Van Veen
Staff Law Clerk

cc: KIRK M. HARTUNG
NANCY J. LINCK

Appendix C

IN RE LONARDO, 96-1101,-1123,-1124
(PTO – 08/218,756)

Note: Pursuant to Fed. Cir. R. 47.6, this order is not citable as precedent. It is a public record.

APPENDIX D — DECISION OF THE PATENT AND TRADEMARK OFFICE FOR THE BOARD OF PATENT APPEALS AND INTERFERENCES ON REEXAMINATION PROCEEDING 90/003,343 DATED OCTOBER 13, 1995

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex Parte RESTORATIVE CARE OF AMERICA INC.

Appeal No. 95-4499
Reexamination Proceeding 90/003,343[1]

ON BRIEF

Before COHEN, LYDDANE and FRANKFORT, *Administrative Patent Judges.*

COHEN, *Administrative Patent Judge.*

This is an appeal from the final rejection of claims 9 and 11, all of the claims remaining in this reexamination proceeding for U.S. Patent No. 5,269,748 ('748 patent). These claims have

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1. Reexamination proceeding of U.S. Patent 5,269,748, issued December 14, 1993 to Robert Lonardo, based on Application 08/020,222, filed February 16, 1993, which is a continuation of Application 05/399,365, filed September 21, 1973, now abandoned, which is a continuation-in-part of Application 05/237,643, filed March 24, 1972, now abandoned, which is a continuation-in-part of Application 05/086,647, filed November 4, 1970, now abandoned.

been amended (Paper No. 6). Appellant's (patent owner's) brief informs us that, due to a terminal disclaimer, the aforementioned patent will expire on October 14, 1995 (brief, page 1).

Appellant's invention pertains to a therapeutic leg and foot device. A basic understanding of the invention can be derived from a reading of exemplary claim 9, a copy of which is appended to this opinion. Also attached hereto is a copy of cancelled claim 1, from which claim 9 depends.

In a double patenting rejection, the examiner relies upon the reissue patent of appellant specified below:[2]

Lonardo ('762 patent)	Re. 33,762	Dec. 10, 1991

The following rejection is the sole rejection before us for review.

Claims 9 and 11 stand rejected under the judicially created doctrine of double patenting.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the final office action in reexamination and the answer (Paper Nos. 10 and 15), while the complete statement of appellant's argument can be found in the brief (Paper No. 13).[3]

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2. This patent is a reissue of U.S. Patent No. 3,976,059, issued Aug. 24, 1976. As pointed out by appellant in the brief (page 6), this reissued patent has expired. Accordingly, we appreciate that, as regards the double patenting rejection on appeal, the procedure of filing a terminal disclaimer to overcome the rejection is unavailable.

3. We note that the request for an oral hearing was withdrawn by appellant (Paper No. 16).

Appendix D

In the brief (page 6), appellant indicates that claims 9 and 11 are grouped together, and stand or fall together. Accordingly, in our analysis, *infra,* we shall focus our attention exclusively upon independent claim 9.

OPINION

In reaching our conclusion on the issues raised on appeal, this panel of the board has carefully considered appellant's specification and claims 9 and 11,[4] the claims of Re. 33,762, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We first address a threshold issue raised by appellant.

In appellant's view (brief, pages 6 through 8), the reexamination is improper and must be terminated. Appellant reasons that since the examiner is relying upon a patent in the double patenting rejection which is not prior art, reexamination is improperly broadened beyond new questions of patentability premised upon prior art patents or printed publications.

At this point, we note, as did the examiner (answer, page 3) that a panel of this board in *Ex parte Obiaya*, 227 USPQ 58 (Bd. Pat. App. & Int. 1985), *aff'd mem.*, 795 F.2d 1017 (Fed. Cir. 1986), determined that a double patenting rejection falls

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4. We note that, during reexamination, claims are given their broadest reasonable interpretation, consistent with the specification. Additionally, claim language is read in light of the specification as it would be interpreted by one of ordinary skill in the art. See *In re Yamamoto*, 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984).

within the ambit of those intended by the statute and not specifically excluded by the court in *In re Etter,* 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985).

We would only add the following additional commentary. It does not appear to us that appellant has appreciated the statutory authority of the Commissioner under 35 U.S.C. § 303 to consider "other patents" during reexamination, apart from the "prior art consisting of patents and printed publications" specified in 35 U.S.C. § 301. With this understanding, it should be clear that a double patenting rejection is appropriate during a reexamination proceeding.

We turn now to the examiner's double patenting rejection.

Briefly stated, the argument advanced by appellant does not convince us that the examiner's double patenting rejection is unsound. Our reasoning in support of this view follows.

In rejecting claims 9 and 11 of U.S. Patent No. 5,269,748 ('748 patent), now undergoing reexamination, the examiner relies upon the claims of U.S. Reissue Patent No. 33,762 ('762 patent). We are informed by appellant in the brief (pages 6 and 7) that these patents have identical priority in that they are based upon identical chains of applications.

Appellant indicates that there are only two types of double patenting: same invention and obviousness (brief, page 9). In the answer (page 4), the examiner appropriately makes reference to *In re Van Ornum,* 686 F.2d 937, 214 USPQ 761 (CCPA 1982). In that case, the court reiterated that 35 U.S.C. § 101 precludes two patents for the same invention, *i.e.,* claims to identical subject matter. The court went on, however, to further point out

that the classification of "obviousness type double patenting" has, in the course of time, come, somewhat loosely, to indicate "any 'double patenting' situation other than one of the 'same invention' type."

In the present proceeding, the claims on appeal ('748 patent) are drawn to a therapeutic leg and foot device, while the claims of the '762 patent relied upon by the examiner likewise address a therapeutic leg and foot device. However, there are differences between the aforementioned claims. The examiner's double patenting rejection is appropriately not under 35 U.S.C. § 101 since the claims do not address "identical subject matter". See *Studiengesellchaft Kohle, mbH v. Northern Petrochemical Company,* 784 F.2d 351, 228 USPQ 837 (Fed. Cir. 1986). Thus, it is clear to us that the examiner's double patenting rejection falls within the classification of "obviousness type double patenting" which, as pointed out above, indicates "any 'double patenting' situation other than one of the 'same invention' type."

Appellant points out (brief, page 15) that one who practices the invention set forth in claims 9 and 11 of the '748 patent does not infringe the claims of the '762 patent,

> unless the L-shaped member is made from *transparent acrylic plastic* with *contoured* leg and foot portions, the foot portion being *shorter* than the adult human foot, the leg portion being substantially *flattened* at the heel portion, the heel portion being *narrower* than the leg and foot portions, and the foot portion exerting a pressure of *30-50 lbs.*

Appellant then makes the point (brief, page 16) that in the present case

> the world is free to use the invention set out in the '762 claims, so long as the invention set forth in the '748 claims 9 and 11 are not used. This can be accomplished very easily by avoiding use of the cut-out portion in the heel of the sandal, as required by claims 9 and 11.

Appellant errs in the view that the world is free to use the therapeutic leg and foot device of expired patent '762 by avoiding use of the cut out portion in the heel of the sandal, as required by claim 9, for example. Our reasons for this conclusion appear below.

We first look at claim 9 of the '748 patent. Dependent claim 9 addresses a therapeutic leg and foot device which includes, *inter alia,*

> said means for releasably securing said device to the leg and the foot of a patient is comprised of a sandal extending substantially over said foot portion and the foot of the patient with a cut out heel portion adjacent said heel portion of said L-shaped member and said space.

Turning now to the claims of the '762 patent, we find that claim 1 is drawn to a therapeutic leg and foot device that comprises, *inter alia,* means for releasably securing the device to the leg and foot of a patient.

In the brief (page 16), appellant is critical of the examiner's interpretation of the above claim language as "inappropriately

reading an additional narrower limitation into the '762 claims, that is, a cut-out portion of the heel of the sandal". Citing precedent, appellant argues that it is an axiom of patent law that limitations in the specification cannot be read into claims. On the facts of the present case, we disagree with appellant's understanding of the law, as it pertains to this proceeding.

The means recitation in claim 1 of the '762 patent is a sixth paragraph means recitation (35 U.S.C. § 112, sixth paragraph). In accordance with *In re Donaldson Co., Inc.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), this panel of the board construes the noted means recitation as covering the structure described in appellants' specification and equivalents thereof. Thus, we understand the means recitation in claim 1 of the '762 patent as covering the sandal described in appellant's specification that is provided with a cut out heel portion and equivalents thereof.

We refer back now to appellant's assertion that the world is free to use the therapeutic foot and leg device of expired patent '762 by avoiding use of the cut out portion in the heel of the sandal. Contrary to appellant's view, we have shown that both the therapeutic leg and foot device of the '748 patent on appeal and claim 1 of the '762 patent require a sandal with a cut out heel portion. Claim 2 of the '762 patent, dependent from claim 1, includes a space between the heel portion and the patient's heel. Thus, contrary to the position taken by appellant, it can be clearly seen that the world is not free to use the therapeutic leg and foot device of expired patent '762. The therapeutic leg and foot device claims of the '748 patent on appeal continue to preclude the use of the therapeutic device of the expired '762 patent.

As pointed out by the court in *In re Schneller*, 397 F.2d 350, 354, 158 USPQ 210, 214 (CCPA 1968),

Appendix D

> The fundamental reason for the rule [against double patenting] is to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about.
>
> [An] appellant has the burden of establishing that the invention claimed in his patent is "independent and distinct" from the invention of the appealed claims. The public policy considerations underlying 35 U.S.C. § 121 permit separate patents on "independent and distinct" inventions which are initially "claimed in one application." The statute places initial responsibility for this determination on the Commissioner of Patents. Where, as here, no such determination has been made, it is necessary to scrutinize carefully an applicant's voluntary alleged determination of this issue for it can lead to the improper proliferation of patents on the same invention with the inherent result of extending timewise a patentee's right to exclude others from the invention disclosed in the original application and on which his patent has issued.

This panel of the board finds that the argument advanced by appellant in the brief does not establish that the claimed therapeutic leg and foot device of the '748 patent is an independent and distinct invention relative to the therapeutic leg and foot device claimed in the '762 patent.

Appendix D

We are in basic agreement with the views as expressed by the examiner (answer, pages 4 through 8). The invention on appeal was fully disclosed in the '762 patent and covered by a claim of that patent. Further, no reason has been given as to why appellant was prevented from presenting the claims on appeal for examination in the '762 patent. We find no excuse or mitigating circumstances making it either reasonable or equitable to make an exception to the rule against double patenting and, therefore, the aforementioned rule must be applied. We note at this time that, as earlier indicated, a terminal disclaimer is not available in the present case to prevent a double patenting result. See *In re Schneller, supra.*

Since the respective claims of the '748 and '762 patents do not evidence independent and distinct inventions, implicit in the above assessment is the understanding that restriction between the inventions defined thereby under 35 U.S.C. § 121 would have been inappropriate, if both had been claimed in the same application. Relative to the absence of an earlier restriction requirement, the concurring opinion of Judge Rich in *In re Zickendraht,* 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) is worthy of note.

The double patenting case of *General Foods Corp. v. Studiengesellschaft Kohle mbH,* 972 F.2d 1272, 23 USPQ2d 1839 (Fed. Cir. 1992), cited throughout appellant's brief, does not support appellant's position that there is no double patenting in the present instance, since it is clear that the court therein determined that there were separate and distinct inventions.

In summary, on the facts of the present case, we have determined that the examiner's conclusion of double patenting is sound. Thus, the rejection of claims 9 and 11 under the judicially created doctrine of double patenting is affirmed.

Appendix D

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED

s/ Irwin Charles Cohen
IRWIN CHARLES COHEN
Administrative Patent Judge

s/ William E. Lyddane
WILLIAM E. LYDDANE
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INFERENCES

s/ Charles E. Frankfort
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Appendix D

APPENDIX

CLAIM 9

9. The device of claim 1 wherein said means for releasably securing said device to the leg and the foot of a patient is comprised of a sandal extending substantially over said foot portion and the foot of the patent [sic, patient] with a cut out heel portion adjacent said heel portion of said L-shaped member and said space.

CANCELLED CLAIM 1

[1. A therapeutic leg and foot device, comprising, an L-shaped member comprised of a one piece flexible plastic material;

said L-shaped member having a leg portion, a heel portion integral with one end of said leg portion, and a foot portion extending integrally from said heel portion at right angles to said leg portion,

said heel portion having a configuration to provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patent's heel by the heel portion when the posterior region of the lower leg and sole of the foot of a patient wearing the device are in supporting contact with said leg portion and said foot portion, respectively, resulting from the configuration of said heel portion,

said heel portion having substantially free and unflanged side edges to permit lateral visibility of said space and a patient's heel suspended within said space, and

means for releasably securing said device to the leg and foot of a patient.]

APPENDIX E — DECISION OF THE PATENT AND TRADEMARK OFFICE FOR THE BOARD OF PATENT APPEALS AND INTERFERENCES ON REEXAMINATION PROCEEDING 90/003,494 DATED OCTOBER 13, 1995

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte RESTORATIVE CARE OF AMERICA INC.

Appeal No. 95-4500
Reexamination Proceeding 90/003,494[1]

ON BRIEF

Before COHEN, LYDDANE and FRANKFORT, *Administrative Patent Judges.*

COHEN, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1, 2, and 5, all of the claims remaining in this reexamination

1. Reexamination proceeding of U.S. Patent 5,298,013, issued March 29, 1994 to Robert Lonardo, based on Application 08/052,517, filed April 29, 1993, which is a division of Application 08/020,222, filed February 16, 1993, now U.S. Patent No. 5,269,748, issued, which is a continuation of Application 05/399,365, filed September 21, 1973, now abandoned, which is a continuation-in-part of Application 05/237,643, filed March 24, 1972, now abandoned, which is a continuation-in-part of Application 05/086,647, filed November 4, 1970, now abandoned.

proceeding for U.S. Patent No. 5,298,013. We are informed by appellant (patent owner) that due to a terminal disclaimer, this patent will expire on October 14, 1995 (brief, page 1).

Appellant's invention pertains to the method of healing or preventing decubitus on the heel of a bedfast patient. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which is appended to this opinion.

In a double patenting rejection, the examiner relies upon the reissue patent of appellant specified below:[2]

Lonardo	Re. 33,762	Dec. 10, 1991

The following rejection is the sole rejection before us for review.

Claims 1, 2, and 5 stand rejected under the judicially created doctrine of double patenting.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the final office action in reexamination and the answer (Paper Nos. 10 and 13), while the complete statement of appellant's argument can be found in the brief (Paper No. 12).[3]

---

2. This patent is a reissue of U.S. Patent No. 3,976,059, issued Aug. 24, 1976. As pointed out by appellant in the brief (page 10), this reissued patent has expired. Accordingly, we appreciate that, as regards the double patenting rejection on appeal, the procedure of filing a terminal disclaimer to overcome the rejection is unavailable.

3. We note that the request for an oral hearing was withdrawn by appellant (Paper No. 14).

Appendix E

In the brief (page 7), appellant indicates that claims 1, 2, and 5 are grouped together, and stand or fall together. Accordingly, in our analysis, *infra*, we shall focus our attention exclusively upon independent method claim 1.

OPINION

In reaching our conclusion on the issues raised in this appeal, this panel of the board has carefully considered appellant's specification and method claims, the claims of Re. 33,762, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We first address a threshold issue raised by appellant.

In appellant's view (brief, pages 8 through 10), the reexamination is improper and must be terminated. Appellant reasons that since the examiner is relying upon a patent in the double patenting rejection which is not prior art, reexamination is improperly broadened beyond new questions of patentability premised upon prior art patents or printed publications.

At this point, we note, as did the examiner (answer, page 3) that a panel of this boarding *Ex parte Obiaya*, 227 USPQ 58 (Bd. Pat. App. & Int. 1985), *aff'd mem.*, 795 F.2d 1017 (Fed. Cir. 1986), determined that a double patenting rejection falls within the ambit of those intended by the statute and not specifically excluded by the court in *In re Etter*, 756 F.2d 852, 225 USPQ 1 (Fed. Cir. 1985).

We would only add the following additional commentary. It does not appear to us that appellant has appreciated the

statutory authority of the Commissioner under 35 U.S.C. § 303 to consider "other patents" during reexamination, apart from the "prior art consisting of patents and printed publications" specified in 35 U.S.C. § 301. With this understanding, it should be clear that a double patenting rejection is appropriate during a reexamination proceeding.

We turn now to the examiner's double patenting rejection.

Simply stated, the argument advanced by appellant in the brief does not persuade us that the examiner's double patenting rejection is unsound.

In rejecting the method claims of U.S. Patent No. 5,298,013 ('013 patent), now undergoing reexamination, the examiner relies upon the claims of U.S. Reissue Patent No. 33,762 ('762 patent). Appellant informs us in the brief (page 9) that these patents have identical priority in that they are based upon identical chains of applications.

Appellant indicates that there are only two types of double patenting: same invention and obviousness (brief, page 12). In the answer (page 4), the examiner appropriately makes reference to *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982). In that case, the court reiterated that 35 U.S.C. § 101 precludes two patents for the same invention, *i.e.*, claims to identical subject matter. The court went on, however, to further point out that the classification of "obviousness type double patenting" has, in the course of time, come, somewhat loosely to indicate "any 'double patenting' situation other than one of the 'same invention' type."

In the present proceeding, the claims on appeal ('013 patent)

are drawn to a method of healing or preventing decubitus on the heal of a bedfast patient, while the claims of the '762 patent relied upon by the examiner address a therapeutic leg and foot device. Thus, two statutory classes of invention are involved. The examiner's double patenting rejection is appropriately not under 35 U.S.C. § 101 since claims drawn to different statutory classes of subject matter do not address "identical subject matter", *i.e.*, they are not drawn to the same invention. See *Studiengesellschaft Kohle, mbH v. Northern Petrochemical Company*, 784 F.2d 351, 228 USPQ 837 (Fed. Cir. 1986). Thus, it is clear to us that the examiner's double patenting rejection falls within the classification of "obviousness type double patenting" which, as pointed out above, indicates "any 'double patenting' situation other than one of the 'same invention' type."

Appellant points out (brief, page 18) that one who practices the *method* invention set forth in claims 1, 2, and 5 of the '013 patent does not infringe the *apparatus* claims of the '762 patent,

> unless the L-shaped member used in the method is made from *transparent acrylic plastic* with *contoured* leg and foot portions, the foot portion being shorter than the adult human foot, the leg portion being substantially *flattened* at the heel portion, the heel portion being *narrower* than the leg and foot portions, and the foot portion exerting a pressure of *30-50 lbs.*

Appellant then makes the point (brief, page 19) that in the present case

> the world is free to use the apparatus

> invention set out in the '762 claims, so long as the method invention set forth in the '013 claims 1, 2, and 5 is not used. This can be accomplished very easily by not cutting out a heel portion of the sandal adjacent the heel portion of said L-shaped member and space, as required by claims 1, 2, and 5.

Appellant errs in the view that the world is free to use the therapeutic leg and foot device of expired patent '762 by not cutting out a heel portion of the sandal adjacent the heel portion of the L-shaped member and space, as required by claim 1, for example. Our reasoning in support of this viewpoint follows.

We turn now to the claims of the '013 patent. Claim 1 addresses a method which includes, *inter alia,* the steps of

> securing said L-shaped member to the leg and foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and *cutting out a heel portion of said sandal* adjacent said heel portion of said L-shaped member and said space. (underlining added for emphasis).

At this point, we note that, during reexamination, claims are given their broadest reasonable interpretation, consistent with the specification. Additionally, claim language is read in light of the specification as it would be interpreted by one of ordinary skill in the art. See *In re Yamamoto,* 740 F.2d 1569, 222 USPQ 934 (Fed. Cir. 1984).

With the above in mind, we now consider the language of

the method steps quoted above. The step of securing a sandal is followed in the claim by the recitation "cutting out of a heel portion of said sandal".

To understand these recitations, we read same in light of the underlying disclosure. The '013 patent (column 3, lines 49 through 60) indicates that any suitable means may be used to secure the leg and foot device to the leg and foot of a patient, for example, a soft leather sleeve or sandal which is slipped over the patient's foot and the foot portion of the device. With clear reference to the sleeve or sandal, the patent goes on to specify that "It is provided with a cut out heel portion with strips 31 and 32 passing under the foot and strips 33 behind the upper heel."

When the aforementioned language of claim 1 of the '013 patent is thus read in light of the underlying disclosure, it is clear to this panel of the board that the securing step secures a sandal provided with a cut out heel portion. This is the only interpretation that is consistent with the patent's disclosure.

Turning now to the claims of the '762 patent, we find that claim 1 is drawn to a therapeutic leg and foot device that comprises, *inter alia,* means for releasably securing the device to the leg and foot of a patient.

In the brief (page 19), appellant is critical of the examiner's interpretation of the above claim language as "inappropriately reading additional narrower limitations into the '762 claims, that is, cutting out a heel portion of the sandal". Citing precedent, appellant argues that it is an axiom of patent law that limitations in the specification cannot be read into claims. On the facts of the present case, we disagree with appellant's understanding of the law, as it pertains to this proceeding.

Appendix E

The means recitation in claim 1 of the '762 patent is a sixth paragraph means recitation (35 U.S.C. § 112, sixth paragraph). In accordance with I*n re Donaldson Co., Inc.*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), this panel of the board construes the noted means recitation as covering the structure described in appellants' specification and equivalents thereof. Thus, we understand the means recitation in claim 1 of the '762 patent as covering the sandal described in appellant's specification that is provided with a cut out heel portion and equivalents thereof.

We refer back now to appellant's assertion that the world is free to use the therapeutic foot and leg device of expired patent '762 by not cutting out a heel portion of the sandal adjacent the heel portion of the L-shaped member and space. Contrary to appellant's view, we have shown that both the method of claim 1 of the '013 patent on appeal and claim 1 of the '762 patent require a sandal with a cut out heel portion. Claim 2 of the '762 patent, dependent from claim 1, includes the space between the heel portion and the patient's heel. Thus, contrary to the position taken by appellant, it can be clearly seen that the world is not free to use the therapeutic leg and foot device of expired patent '762. The method claims of the '013 patent on appeal continue to preclude the use of the therapeutic device of the expired '762 patent.

As pointed out by the court in *In re Schneller,* 397 F.2d 350, 354, 158 USPQ 210, 214 (CCPA 1968),

> The fundamental reason for the rule [against double patenting] is to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about.

Appendix E

> [An] appellant has the burden of establishing that the invention claimed in his patent is "independent and distinct" from the invention of the appealed claims. The public policy considerations underlying 35 U.S.C. § 121 permit separate patents on "independent and distinct" inventions which are initially "claimed in one application." The statute places initial responsibility for this determination on the Commissioner of Patents. Where, as here, no such determination has been made, it is necessary to scrutinize carefully an applicant's voluntary alleged determination of this issue for it can lead to the improper proliferation of patents on the same invention with the inherent result of extending timewise a patentee's right to exclude others from the invention disclosed in the original application and on which his patent has issued.

The argument advanced by appellant has simply not established that the claimed method of healing or preventing decubitus on the heel of a bedfast patient of the '013 patent is an independent and distinct invention relative to the therapeutic[4] leg and foot device claimed in the '762 patent. Being a "therapeutic" leg and foot device, as expressly claimed, we

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4. The word or term "therapeutic" has been defined as "of or relating to the treatment of disease or disorders by remedial agents or methods." Webster's New Collegiate Dictionary, G. & C. Merriam Company, Springfield, Massachusetts, 1979. This basic definition is consistent with appellant's disclosure of therapeutic methods applying the L-shaped member for correcting, healing, or preventing foot disorders.

certainly believe it fair to say that the device would clearly be used in a *method* relating to the treatment of a disease or disorder.[5]

The invention on appeal was fully disclosed in the '762 patent and no reason has been given as to why appellant was prevented from presenting the claims on appeal for examination in the '762 patent. We find no excuse or mitigating circumstances making it either reasonable or equitable to make an exception to the rule against double patenting and, therefore, the aforementioned rule must be applied. We note at this time that, as earlier indicated, a terminal disclaimer is not available in the present case to prevent a double patenting result. See *In re Schneller, supra.*

At this point, we note that in the case of *In re Sebek*, 347 F.2d 632, 146 USPQ 44 (CCPA 1965) a claim for a method for the treatment of human and veterinary inflammatory conditions comprising the step of administering a pharmaceutical preparation was determined to be a double patenting of a claim to an enteral pharmaceutical preparation in dosage unit form.

The claimed method of healing or preventing decubitus on the heel of a bedfast patient of the '013 patent is further not seen to be a distinct invention relative to the therapeutic leg and foot device claimed in the '762 patent because the separately claimed therapeutic leg and foot device, with its L-shaped member having foot and leg portions at right angles relative to one another, space between its heel portion and a patient's heel,

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5. Appellant has not made a convincing showing that the method as claimed can be practiced by another materially different therapeutic leg and foot device, or that the therapeutic leg and foot device as claimed can be used to practice another and materially different method.

and a sandal with cutout heel portion (means for securing recitation), clearly constitutes the essential distinguishing feature detailed in the claimed method. Additionally, it is noted that the separately claimed therapeutic foot and leg device is expressly specified as a "therapeutic" device, and not a device just for general use. Thus, different inventive concepts are not involved as between the claimed device and method. See *In re Coleman*, 189 F.2d 976, 90 USPQ 100 (CCPA 1951). Since the claimed device and method are not independent and distinct inventions, implicit in the above assessment is the circumstance that restriction between the device and method under 35 U.S.C. § 121 would have been inappropriate, if both had been claimed in the same application. Relative to the absence of an earlier restriction requirement, the concurring opinion of Judge Rich in *In re Zickendraht*, 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) is worthy of note. Thus, on the facts of the present case, we have determined that the examiner's double patenting rejection is sound.

In summary, the rejection of claims 1, 2, and 5 under the judicially created doctrine of double patenting is affirmed.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED

Appendix E

s/ Irwin Charles Cohen
IRWIN CHARLES COHEN
Administrative Patent Judge

s/ William E. Lyddane
WILLIAM E. LYDDANE
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
INFERENCES

s/ Charles E. Frankfort
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Appendix E

APPENDIX

CLAIM 1

1. The method of healing or preventing decubitus on the heel of a bedfast patient, comprising,

placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion on one end of said leg portion, and a foot portion extending from said heel portion at right angles to said leg portion,

forming the shape of said heel portion so that the shape alone of said heel portion will provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respective,

and securing said L-shaped member to the leg and foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and cutting out a heel portion of said sandal adjacent said heel portion of said L-shaped member and said space.

APPENDIX F — DECISION OF THE PATENT AND TRADEMARK OFFICE FOR THE BOARD OF PATENT APPEALS AND INTERFERENCES ON APPLICATION NO. 08/218,756 DATED OCTOBER 13, 1995

Paper No. 24

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte ROBERT LONARDO

Appeal No. 95-4476
Application 08/218,756[1]

ON BRIEF

Before COHEN, LYDDANE and FRANKFORT, *Administrative Patent Judges.*

COHEN, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal from the final rejection of claim 1, the sole claim remaining in this application Serial No. 08/218,756

1. Application for patent filed March 28, 1994. According to applicant, the application is a continuation of Application 08/052,517, filed April 29, 1993, now Patent No. 5,298,013, issued March 29, 1994, which is a division of Application 08/020,222, filed February 16, 1993, now U.S. Patent No. 5,269,748, issued December 14, 1993, which is a continuation of Application 05/399,365, filed September 21, 1973, now abandoned, which is a continuation-in-part of Application 05/237,643, filed March 24, 1972, now abandoned, which is a continuation-in-part of Application 05/086,647, filed November 4, 1970, now abandoned.

('756 application). We are informed (Paper No. 14) that, in view of terminal disclaimers filed in the application and its related parent applications, any patent that would issue in this application will expire on October 14, 1995.

Appellant's invention pertains to the method of healing or preventing decubitus on the heel of a bedfast patient. A basic understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which is appended to this opinion.

In a double patenting rejection, the examiner relies upon the reissue patent of appellant specified below:[2]

Lonardo	Re. 33,762	Dec. 10, 1991

The following rejection is the sole rejection before us for review.

Claim 1 stands rejected under the judicially created doctrine of double patenting.

The full text of the examiner's rejection and response to the argument presented by appellant appears in the final rejection and the answer (Paper Nos. 17 and 20), while the complete statement of appellants argument can be found in the brief (Paper No. 18).[3]

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2. This patent is a reissue of U.S. Patent No. 3,976,059, issued Aug. 24, 1976. This reissued patent has expired, as indicated by appellant (brief, page 6). Accordingly, we appreciate that, as regards the double patenting rejection on appeal, the procedure of filing a terminal disclaimer to overcome the rejection is unavailable.

3. We note that the request for an oral hearing was withdrawn by appellant (Paper No. 22).

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OPINION

In reaching our conclusion on the double patenting issue raised in this appeal, this panel of the board has carefully considered appellant's specification and independent method claim 1, the claims of Re. 33,762, and the respective viewpoints of appellant and the examiner. As a consequence of our review, we make the determination which follows.

This panel of the board is not persuaded by the argument advanced by appellant in the brief that the examiner's double patenting rejection is unsound. Our reasoning underlying this determination appears below.

In rejecting method claim 1 of the present application ('756 application), the examiner relies upon the claims of Reissue Patent No. 33,762 ('762 patent).

Appellant indicates that there are only two types of double patenting: same invention and obviousness (brief, page 6). In the answer (page 3), the examiner appropriately makes reference to *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982). In that case, the court reiterated that 35 U.S.C. § 101 precludes two patents for the same invention, *i.e.*, claims to identical subject matter. The court went on, however, to further point out that the classification of "obviousness type double patenting" has, in the course of time, come, somewhat loosely, to indicate "any 'double patenting' situation other than one of the 'same invention' type."

In the present '756 application, the sole independent method claim 1 on appeal is drawn to a method of healing or preventing decubitus on the heal of a bedfast patient, while the claims of

the '762 patent relied upon by the examiner address a therapeutic leg and foot device. Thus, two statutory classes of invention are involved. The examiner's double patenting rejection is appropriately not under 35 U.S.C. § 101 since claims drawn to different statutory classes of subject matter do not address "identical subject matter", *i.e.*, they are not drawn to the same invention. See *Studiengesellchaft Kohle, mbH v. Northern Petrochemical Company*, 784 F.2d 351, 228 USPQ 837 (Fed. Cir. 1986). Thus, it is clear to us that the examiner's double patenting rejection falls within the classification of "obviousness type double patenting" which, as pointed out above, indicates "any 'double patenting' situation other than one of the 'same invention' type."

Appellant points out (brief, page 13) that one who practices the *method* invention set forth in claim 1 of the '756 application does not infringe the *apparatus* claims of the '762 patent,

> unless the L-shaped member used in the method is made from *transparent acrylic plastic* with *contoured* leg and foot portions, the foot portion being *shorter* than the adult human foot, the leg portion being substantially *flattened* at the heel portion, the heel portion being *narrower* than the leg and foot portions, and the foot portion exerting a pressure of *30-50 lbs.*

Appellant goes on to make the point (brief, page 13-14) that in the present case.

> the world is free to use the apparatus invention set out in the '762 claims, so long

> as the method invention set forth in the '756 claim 1 is not used. This can be accomplished very easily by not providing an opening in the sandal adjacent the heel portion of said L-shaped member and the space to permit visual inspection of the space from a lateral direction, as required by claim 1.

Appellant errs in the view that the world is free to use the therapeutic leg and foot device of expired patent '762 by not providing an opening in the sandal adjacent the heel portion of the L-shaped member and space to permit visual inspection of the space from a lateral direction, as required by claim 1. An explanation of our viewpoint follows.

We first turn to the claims of the '756 application. Claim 1 addresses a method which includes, *inter alia,* the steps of

> securing said L-shaped member to the leg and foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient,
>
> and providing an opening in said sandal adjacent said heel portion of said L-shaped member and said space to permit visual inspection of said space from a lateral direction.[4]

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4. The disclosure (page 3) indicates that the device retains the foot in fixed position while maintaining a spaced relation with the heel. This (the spaced relation) makes it (heel and adjacent areas) easily accessible to the doctor for examination. Additionally, the disclosure (page 9) points out that the transparency of the device allows the involved area to be constantly observed, and that the device allows frequent observation by a doctor during healing.

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At this point, we note that in proceedings before the Patent and Trademark Office, claims in an application are given their broadest reasonable interpretation consistent with the specification. Additionally, claim language is read in light of the specification as it would be interpreted by one of ordinary skill in the art. See *In re Sneed*, 710 F.2d 1544, 218 USPQ 385 (Fed. Cir. 1983).

With the above in mind, we now consider the language of the method steps quoted above. The step of securing a sandal is followed in the claim by the step of providing an opening in said sandal adjacent said heel portion of said L-shaped member and said space to permit visual inspection of said space from a lateral direction.

To understand these recitations, we read same in light of the underlying disclosure. The '756 application (pages 7 and 8) indicates that any suitable means may be used to secure the leg and foot device to the leg and foot of a patient, for example, a soft leather sleeve or sandal which is slipped over the patient's foot and the foot portion of the device. With clear reference to the sleeve or sandal, the application goes on to specify that "It is provided with a cut out heel portion with strips 31 and 32 passing under the foot and strips 33 behind the upper heel."

When the aforementioned language of claim 1 of the '756 application is thus read in light of the underlying disclosure, it is clear to this panel of the board that the step of providing an opening provides the sandal with a cut out heel portion. This is the only interpretation that is consistent with the application's disclosure. Of course, it is also readily apparent to us that being an opening it provides for seeing therethrough, *i.e.*, it permits visual inspection of the space from a lateral direction.

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Turning now to the claims of the '762 patent, we find that claim 1 is drawn to a therapeutic leg and foot device that comprises, *inter alia,* means for releasably securing the device to the leg and foot of a patient.

In the brief (page 14), appellant is critical of the examiner's interpretation of the above claim language as "inappropriately reading additional narrower limitations into the '762 claims, that is, providing an opening in the sandal adjacent the heel portion and the space to permit visual inspection from a lateral direction." Citing precedent, appellant argues that it is an axiom of patent law that limitations in the specification cannot be read into claims. On the facts of the present case, we disagree with appellant's understanding of the law, as it pertains to this appeal.

The means recitation in claim 1 of the '762 patent is a sixth paragraph means recitation (35 U.S.C. § 112, sixth paragraph). In accordance with *In re Donaldson Co., Inc.,* 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), this panel of the board construes the noted means recitation as covering the structure described in appellants' specification and equivalents thereof. Thus, we understand the means recitation in claim 1 of the '762 patent as covering the sandal described in appellant's specification that is provided with a cut out heel portion, with the cut out portion, of course, permitting visual inspection of the space from a lateral direction.

We refer back now to appellant's assertion that the world is free to use the therapeutic foot and leg device of expired patent '762 by not providing an opening in the sandal adjacent the heel portion of the L-shaped member and space to permit visual inspection of the space from a lateral direction. Contrary to appellant's view, we have shown that both the method of claim

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1 of the '756 application on appeal and claim 1 of the '762 patent require a sandal with a cut out heel portion. Claim 2 of the '762 patent, dependent from claim 1, includes the space between the heel portion and the patient's heel. Thus, contrary to the position taken by appellant, it can be clearly seen that the world is not free to use the therapeutic leg and foot device of expired patent '762. The method claim of the '756 application on appeal would preclude the use of the therapeutic device of the expired '762 patent.

As pointed out by the court in *In re Schneller,* 397 F.2d 350, 354, 158 USPQ 210, 214 (CCPA 1968),

> The fundamental reason for the rule [against double patenting] is to prevent unjustified timewise extension of the right to exclude granted by a patent no matter how the extension is brought about.
>
> [An] appellant has the burden of establishing that the invention claimed in his patent is "independent and distinct" from the invention of the appealed claims. The public policy considerations underlying 35 U.S.C. § 121 permit separate patents on "independent and distinct" inventions which are initially "claimed in one application." The statute places initial responsibility for this determination on the Commissioner of Patents. Where, as here, no such determination has been made, it is necessary to scrutinize carefully an applicant's voluntary alleged determination of this issue

> for it can lead to the improper proliferation of patents on the same invention with the inherent result of extending timewise a patentee's right to exclude others from the invention disclosed in the original application and on which his patent has issued.

The argument advanced by appellant has simply not established that the claimed method of healing or preventing decubitus on the heel of a bedfast patient of the '756 application is an independent and distinct invention relative to the therapeutic[5] leg and foot device claimed in the '762 patent. Being a "therapeutic" leg and foot device, as expressly claimed, we certainly believe it fair to say that the device would clearly be used in a *method* relating to the treatment of a disease or disorder.[6]

The invention on appeal was fully disclosed in the '762 patent. No reason has been given as to why appellant was prevented from presenting the claim on appeal for examination in the '762 patent. We find no excuse or mitigating circumstances making it either reasonable or equitable to make an exception

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5. The word or term "therapeutic" has been defined as "of or relating to the treatment of disease or disorders by remedial agents or methods." Webster's New Collegiate Dictionary, G. & C. Merriam Company, Springfield, Massachusetts, 1979. This basic definition is consistent with appellant's disclosure of therapeutic methods applying the L-shaped member for correcting, healing, or preventing foot disorders.

6. Appellant has not made a convincing showing that the method as claimed can be practiced by another materially different therapeutic leg and foot device, or that the therapeutic leg and foot device as claimed can be used to practice another and materially different method.

to the rule against double patenting and, therefore, the aforementioned rule must be applied. We recognize at this time that, as earlier indicated, a terminal disclaimer is not available in the present case to prevent a double patenting result. See *In re Schneller, supra.*

At this point, we note that in the case of *In re Sebek*, 347 F.2d 632, 146 USPQ 44 (CCPA 1965) a claim for a method for the treatment of human and veterinary inflammatory conditions comprising the step of administering a pharmaceutical preparation was determined to be a double patenting of a claim to an enteral pharmaceutical preparation in dosage unit form.

The claimed method of healing or preventing decubitus on the heel of a bedfast patient of the '756 application is further not seen to be a distinct invention relative to the therapeutic leg and foot device claimed of the '762 patent because the separately claimed therapeutic leg and foot device, with its L-shaped member having foot and leg portions at right angles relative to one another, space between its heel portion and a patient's heel, and a sandal with cutout heel portion (means for securing recitation), clearly constitutes the essential distinguishing feature detailed in the claimed method. Additionally, it is noted that the separately claimed therapeutic foot and leg device is expressly specified as a "therapeutic" device, and not a device just for general use. Thus, different inventive concepts are not involved as between the claimed device and method. See *In re Coleman*, 189 F.2d 976, 90 USPQ 100 (CCPA 1951). Since the claimed device and method are not independent and distinct inventions, implicit in the above assessment is the circumstance that restriction between the device and method under 35 U.S.C. § 121 would have been inappropriate, if both had been claimed in the same application. Relative to the absence of an earlier

restriction requirement, the concurring opinion of Judge Rich in *In re Zickendraht,* 319 F.2d 225, 232, 138 USPQ 22, 27 (CCPA 1963) is worthy of note. Thus, on the facts of the present case, we have determined that the examiner's double patenting rejection is sound.

In summary, the rejection of independent method claim 1 under the judicially created doctrine of double patenting is affirmed.

The decision of the examiner is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR 1.136(a).

AFFIRMED

s/ Irwin Charles Cohen
IRWIN CHARLES COHEN
Administrative Patent Judge

s/ William E. Lyddane
WILLIAM E. LYDDANE
Administrative Patent Judge

BOARD OF PATENT
APPEALS AND
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Appendix F

APPENDIX

CLAIM 1

1. The method of healing or preventing decubitus on the heel of a bedfast patient, comprising,

placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion secured to one end of said leg portion, and a foot portion extending from said heel portion substantially at right angles to said leg portion,

forming the shape of said heel portion so that the shape alone of said heel portion alone will provide a space between the heel portion and said heel of said patient to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respectively,

securing said L-shaped member to the leg and foot of said patient by using a sandal extending substantially over said foot portion, and the foot of the patient,

and providing an opening in said sandal adjacent said heel portion of said L-shaped member and said space to permit visual inspection of said space from a lateral direction.

APPENDIX G — OFFICE ACTION IN REEXAMINATION ON 90/003,343 MAILED FEBRUARY 7, 1995

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

90/003343

CONTROL NUMBER	FILING DATE	PATENT UNDER REEXAMINATION	ATTORNEY DOCKET NO.
90/003,343	*02/24/94*	*5269748*	*P2094030*

EXAMINER
DVORAK, L

ART UNIT	PAPER NUMBER
3302	*10*

DATE MAILED: *02/07/95*

F3M1/0207

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OFFICE ACTION IN REEXAMINATION

☒ Responsive to the communication(s) filed on *11/21/94*.
☒ This action is made FINAL.

Appendix G

A shortened statutory period for response to this action is set to expire *TWO* month(s) from the date of this letter. Failure to respond within the period for response will cause termination of the proceeding and issuance of a reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERENED BY 37 CFR 1.550(c).**

* * *

PART II SUMMARY OF ACTION:

1a. ☒ Claims *9, 11* are subject to reexamination.

* * *

2. ☒ Claims *1-8, 10* have been cancelled.

* * *

5. ☒ Claims *9, 11* are rejected.

* * *

Appendix G

Double Patenting

The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re White*, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

Claims 9 and 11 are rejected under the judicially created doctrine of double patenting.

The subject matter recited in claims 9 and 11 of the re-exam "means for releasably securing said device to the leg and the foot of a patient is comprised of a sandal extending substantially over said foot portion and the foot of the patent [sic.] with a cut-out heel portion adjacent said heel portion of said splint and said space" is fully disclosed in the patent [Re 33,762]. The allowance of this claim would extend the rights to exclude already granted in claim 1 of the patent. Claim 1 of the patent calls for a "means for releasably securing the device to the leg and foot of the patient". Using the specification in the patent as a dictionary of terms (*In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968)) it is found that the means are the same.

Claim 1 in Re. 33,762 provides the following coverage:

$$A_{Sp} + B_{Br}$$

Appendix G

wherein A_{Sp} is "an L-shaped member of a flexible, transparent, acrylic, plastic, said member having a generally contoured and channel shaped leg portion, a curved heel portion integral with one end of said leg portion, and a generally contoured foot portion extending integrally from said heel portion at right angles to said leg portion, said foot portion being shorter than the adult human foot, the channel shape of said leg portion being substantially flattened at said heel portion, said curved heel portion being narrower than said leg and foot portions and having a free and unflanged edge to permit flexing of said foot portion with respect to said leg portion, said foot portion exerting a pressure of 30 to 50 lbs. toward said leg portion when said foot portion is flexed away from the right angle position"; and

B_{Br} is means for releasably securing the device to the leg and foot of a patient.

The claim or claims because of B_{Br} provides coverage not only to

$$A_{Sp} + B_{Br}$$

but also provides coverage to

$$A_{Sp} + B_{Sp}$$

and

$$A_{Br} + B_{Sp}.$$

B_{Sp} is fully disclosed in U.S. Patent Re. 33,762.

Appendix G

The claims under rejection provide coverage to

$$A_{Br} + B_{Sp}$$

wherein A_{Br} is "an L-shaped flexible member having a leg portion, a heel portion extending from one end of said leg portion, and a foot portion extending from said heel portion at right angles to said leg portion, said heel portion having a configuration to provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by the heel portion when the posterior region of the lower leg and the sole of the foot of a patient wearing the device are in supporting contact with said leg portion and said foot portion, respectively, resulting from the configuration of the heel portion, said heel portion having substantially free and unflanged side edges to permit lateral visibility of said space and a patient's heel suspended within said space",;

and B_{Sp} is "means for releasably securing said device to the leg and the foot of a patient is comprised of a sandal extending substantially over said foot portion and the foot of the patent [sic.] with a cut-out heel portion adjacent said heel portion of said splint and said space".

Clearly the claims provide protection already provided for by the claims of the patent.

If applicant does not come to the same conclusion as to what protection claim 1 of the patent provides as discussed above, applicant is requested to specifically point out why the examiner's conclusions are wrong.

Appendix G

Response to Amendment

In applicant's remarks, applicant argues (pages 1 and 2) that the re-examination is improper because a re-examination can only be premised upon prior art patents and publications pursuant to 35 USC § 302, 37 C.F.R. § 1.510, and MPEP § 2209, and that since the '762 patent does not constitute prior art with respect to the '748 patent, the re-examination request and order are improper.

In response to this point, applicant is reminded that a double patenting issue may be raised in a re-examination proceeding. Ex parte Obiaya, 227 USPQ 58{Bd. Pat. App. & Int. 1985). Although re-examination must be based on prior art patents and printed publications, and a patent relied on in a double patenting rejection need not be "prior art" patent, the Office has taken the position that double patenting rejections are analogous to rejections under 103 and depend on the presence of a prior patent as the basis for the rejection. Accordingly a double patenting issue may be properly addressed in a re-examination proceeding.

Applicant argues (page 2) that claims 9 and 11 were rejected on the grounds of "same invention". The phrase "same invention" means 35 USC 101 double patenting — i.e., statutory type. Applicant is directed to the first sentence of the last Office action:

"The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent" and the associated case law. It is clear that the "same invention" type double patenting was never contemplated.

Appendix G

Applicant on pages 6-8 argues that an obvious-type rejection does not exist. Applicant is correct. The examiner never argued obvious type double patenting. All non-statutory double patenting rejections, whether they are based on an obvious variation of the patented invention or not, have been classified in the past as "obvious-type double patenting" rejections. As the court stated in Van Ornum, 686 F.2d 937,214 USPQ 761 (CCPA 1982):

This latter classification (obvious type double patenting) has, in the course of time, come somewhat loosely to indicate any "double patenting" situation other than one of "same invention" (35 USC 101) type.

There are some unique circumstances where it has been recognized that another type of non-statutory double patenting is applicable even where the inventions claimed in two or more applications/patents are considered non-obvious over each other. These circumstances are illustrated by the facts before the court in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

In making an analysis for this type of non-statutory double patenting the first question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is no, double patenting does not exist. If the answer is yes, as in your case, the second question is: Whether there is any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no, as in your case, a double patenting rejection is appropriate because, as stated in *Schneller*:

. . . even a minimum concern for the public

> interest requires an applicant to establish that the inventions are in fact independent and distinct and hence that the grant of a patent on the later application will not result in a timewise extension of the protection afforded by his earlier patent. Failing in this, an applicant's remedy lies in filing a terminal disclaimer which will effectively prevent this result.

and further:

> Under the circumstances of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or equitable to make an exception, and wherein there is no terminal disclaimer, the rule against "double patenting" must be applied.

A fact situation similar to that in Schneller was presented to a Federal Circuit panel in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were tetraglyme and sulfolane. One unclaimed example in the patent was specifically directed to a mixture of these two solvents. The claims in the application to Kaplan and Walker, the application before the Office, were directed to essentially the same chemical process, but requiring the use of the solvent mixture of tetraglyme and sulfolane. In reversing the double patenting rejection, the court stated that the mere fact that the broad process claim of the patent requiring an organic solvent reads on or "dominates" the narrower claim

directed to basically the same process using a specific solvent mixture does not, per se, justify a double patenting rejection. The court also pointed out that the double patenting rejection improperly used the disclosure of the joint invention (solvent mixture) in the Kaplan patent specification as though it were prior art.

A significant factor in the *Kaplan* case was that the broad invention was invented by Kaplan, and the narrow invention (i.e., using a specific combination of solvents) was invented by Kaplan and Walker. Since these applications were filed before the Patent Law Amendments Act of 1984 (Pub. Law 98-622, § 104, November 8, 1984) amending § 116 to expressly authorize filing a patent application in the names of joint inventors which did not necessarily make a contribution to the invention defined in each claim in the patent, it was necessary to file multiple applications to claim both the broad and the narrow inventions. Accordingly, there was a valid reason why the claims to the specific solvent mixture were not presented for examination in the Kaplan patent application.

Recently, the court held that when a patentee voluntarily elects to file a continuing application to prosecute the broad genus claims, in order to obtain an allowance of a narrow species claim, the species claim precludes issuance of the generic application, absent a terminal disclaimer. *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993). In *Goodman*, the specifications of the patent and the application disclosed the invention in general terms, but provided a single working example; i.e., a method of producing gamma interferon using a DNA construct comprising an expression cassette with expression regulatory elements functional in tobacco plants (a dicotyledonous plant) and a structural gene coding for gamma-interferon. The claims

the Court considered as presenting a double patenting issue were the narrow species claims in the allowed patent directed to a DNA construct comprising expression regulatory elements derived from a specific type of plasmid and which were functional in dicotyledonous plant cells and a structural gene coding for an interferon. The Court held that this type of situation did not require a "two-way" analysis because P.T.O. actions did not dictate the rate of prosecution. The patentee had the opportunity to file an immediate appeal to the courts on the genus, but instead he adopted an easier course of action by filing a continuation application on the broad claims and obtaining issuance of the narrow genus. Although the filing dates of the patent and application were identical, the Court found that this type of situation was sufficiently analogous to a rejection under 35 U.S.C. § 102 wherein an earlier species disclosure defeats any generic claim. *Cf. Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Accordingly the Court held that a terminal disclaimer was necessary in order to prevent the patentee from gaining an unjust extension of the 17-year term on a species application when the broad genus was issued at a later date.

Each double patenting situation has to be decided on its own facts. To the extent that one would view the *Schneller* and *Kaplan* decisions to be in conflict, it is clear that *Schneller* is the controlling precedent. Decisions of a three judge panel cannot overturn prior precedential decisions. See *UMC Elec. Co. v. United States*, 816 F.2d 647, n.6, 2 USPQ 2d 1465, n.6 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1025 (1988).

Unlike statutory double patenting (§ 101), a double patenting rejection based on any non-statutory ground can be overcome by an appropriate terminal disclaimer.

Appendix G

As to any arguments by applicant to domination, domination and double patenting should not be confused. They are two separate issues. "Domination" occurs when one patent has a broad or generic claim which reads on an invention defined in a narrower or more specific claim in another application, and thus dominates the more narrow or specific claim. More simply put, one patent dominates another if a claim of the first patent reads on a device built or process practiced according to the second patent disclosure. Domination, by itself, does not give rise to double patenting. *In re Sarett*, 327 F.2d 2005, 140 USPQ 474, 482 (CCPA 1964) and *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678, 681 (Fed. Cir. 1986).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.550(c).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE TWO MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Appendix G

Any inquiry concerning this communication should be directed to Linda C. M. Dvorak at telephone number (703) 308-0994. In addition, facsimile transmissions concerning this application should be directed to Linda C. M. Dvorak at facsimile number (703) 305-3590.

s/ L.C.M. Dvorak
LCM Dvorak
January 30, 1995

s/ Richard J. Apley
Richard J. Apley
Supervisory Pat. Exr.
Art Unit 3302

APPENDIX H — REEXAMINATION ADVISORY ACTION ON 90/003,343 MAILED APRIL 28, 1995

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

90/003343

CONTROL NUMBER	FILING DATE	PATENT UNDER REEXAMINATION	ATTORNEY DOCKET NO.
90/003,343	*02/24/94*	*5269748*	*P2094030*

EXAMINER
DVORAK, L

ART UNIT	PAPER NUMBER
3302	*11*

DATE MAILED: *04/28/95*

F3M1/0428

DONALD H. ZARLEY
ZARLEY, MCKIE, THOMTE, VORHEES & SEASE
801 GRAND AVENUE, STE. 3200
DES MOINES, IA 50309

REEXAMINATION ADVISORY ACTION

1. ☒ THE PERIOD FOR RESPONSE IS EXTENDED TO RUN *4 MONTHS* MONTH(S) FROM THE DATE OF THE FINAL REJECTION. **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

* * *

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3. ☒ Patent owner's response to the final rejection, filed on *4/7/95*, has been considered with the following effect, but it is not deemed to place the reexamination in condition for issuance of a reexamination certificate.

* * *

6. ☒ Upon the filing of an appeal, the status of the claims in this reexamination would be as follows:

* * *

c. ☒ Claim(s) *9, 11* would not be patentable.

* * *

10. ☒ Other: *See attached response to applicant's arguments.*

* * *

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Double Patenting

The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re White*, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

Claims 9 and 11 are rejected under the judicially created doctrine of double patenting.

The subject matter recited in claims 9 and 11 of the re-exam "means for releasably securing said device to the leg and the foot of a patient is comprised of a sandal extending substantially over said foot portion and the foot of the patent [sic.] with a cut-out heel portion adjacent said heel portion of said splint and said space" is fully disclosed in the patent [Re 33,762]. The allowance of this claim would extend the rights to exclude already granted in claim 1 of the patent. Claim 1 of the patent calls for a "means for releasably securing the device to the leg and foot of the patient". Using the specification in the patent as a dictionary of terms (*In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968)) it is found that the means are the same.

Claim 1 in Re. 33,762 provides the following coverage:

$$A_{Sp} + B_{Br}$$

Appendix H

wherein A_{Sp} is "an L-shaped member of a flexible, transparent, acrylic, plastic, said member having a generally contoured and channel shaped leg portion, a curved heel portion integral with one end of said leg portion, and a generally contoured foot portion extending integrally from said heel portion at right angles to said leg portion, said foot portion being shorter than the adult human foot, the channel shape of said leg portion being substantially flattened at said heel portion, said curved heel portion being narrower than said leg and foot portions and having a free and unflanged edge to permit flexing of said foot portion with respect to said leg portion, said foot portion exerting a pressure of 30 to 50 lbs. toward said leg portion when said foot portion is flexed away from the right angle position"; and

B_{Br} is means for releasably securing the device to the leg and foot of a patient.

The claim or claims because of B_{Br} provides coverage not only to

$$A_{Sp} + B_{Br}$$

but also provides coverage to

$$A_{Sp} + B_{Sp}$$

and

$$A_{Br} + B_{Sp}.$$

B_{Sp} is fully disclosed in U.S. Patent Re. 33,762.

Appendix H

The claims under rejection provide coverage to

$$A_{Br} + B_{Sp}$$

wherein A_{Br} is "an L-shaped flexible member having a leg portion, a heel portion extending from one end of said leg portion, and a foot portion extending from said heel portion at right angles to said leg portion, said heel portion having a configuration to provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by the heel portion when the posterior region of the lower leg and the sole of the foot of a patient wearing the device are in supporting contact with said leg portion and said foot portion, respectively, resulting from the configuration of the heel portion, said heel portion having substantially free and unflanged side edges to permit lateral visibility of said space and a patient's heel suspended within said space",;

and B_{Sp} is "means for releasably securing said device to the leg and the foot of a patient is comprised of a sandal extending substantially over said foot portion and the foot of the patent [sic.] with a cut-out heel portion adjacent said heel portion of said splint and said space".

Clearly the claims provide protection already provided for by the claims of the patent.

Response to Arguments

Patentee in his description of double patenting states that there are only two types — same invention and obviousness. Patentee is correct in his statement that there are only two types, but is incorrect in listing obviousness type as one. There are

two types and they are statutory and non-statutory. Non-statutory is the generic term that encompasses both obvious and non-obvious types. All non-statutory double patenting rejections, whether they are based on an obvious variation of the patented invention or not, have been classified in the past as "obvious-type double patenting" rejections. As the court stated in Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982):

> This latter classification (obvious type double patenting) has, in the course of time, come somewhat loosely to indicate any "double patenting" situation other than one of "same invention" (35 USC 101) type.

In order to distinguish the various non-statutory double patenting situations, the phrase "obviousness type double patenting" will not be used herein unless an obviousness analysis is necessary to support the double patenting rejection.

Further, applicant is incorrect when he states that Schneller was another type of obviousness type double patenting. The Court in Schneller specifically states that Schneller was not of the obviousness type, and Van Ornum reaffirms the principles of Schneller.

As to applicant's arguments concerning domination, domination and double patenting should not be confused. They are two separate issues. "Domination" occurs when one patent has a broad or generic claim which reads on an invention defined in a narrower or more specific claim in another application, and thus dominates the more narrow or specific claim. More simply put, one patent dominates another if a claim of the first patent reads on a device built or process practiced according to the second patent disclosure. Domination, by itself, does not give

rise to double patenting. *In re Sarett*, 327 F.2d 2005, 140 USPQ 474, 482 (CCPA 1964) and *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678, 681 (Fed. Cir. 1986).

Additionally, there are some unique circumstances where it has been recognized that another type of non-statutory double patenting is applicable even where the inventions claimed in two or more applications/patents are considered non-obvious over each other. These circumstances are illustrated by the facts before the court in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

In making an analysis for this type of non-statutory double patenting the first question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is no, double patenting does not exist. If the answer is yes, as in your case, the second question is: Whether there is any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no, as in your case, a double patenting rejection is appropriate because, as stated in *Schneller*:

> . . . even a minimum concern for the public interest requires an applicant to establish that the inventions are in fact independent and distinct and hence that the grant of a patent on the later application will not result in a timewise extension of the protection afforded by his earlier patent. Failing in this, an applicant's remedy lies in filing a terminal disclaimer which will effectively prevent this result.

and further:

> Under the circumstances of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or equitable to make an exception, and wherein there is no terminal disclaimer, the rule against "double patenting" must be applied.

A fact situation similar to that in Schneller was presented to a Federal Circuit panel in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were tetraglyme and sulfolane. One unclaimed example in the patent was specifically directed to a mixture of these two solvents. The claims in the application to Kaplan and Walker, the application before the Office, were directed to essentially the same chemical process, but requiring the use of the solvent mixture of tetraglyme and sulfolane. In reversing the double patenting rejection, the court stated that the mere fact that the broad process claim of the patent requiring an organic solvent reads on or "dominates" the narrower claim directed to basically the same process using a specific solvent mixture does not, per se, justify a double patenting rejection. The court also pointed out that the double patenting rejection improperly used the disclosure of the joint invention (solvent mixture) in the Kaplan patent specification as though it were prior art.

A significant factor in the *Kaplan* case was that the broad invention was invented by Kaplan, and the narrow invention (i.e., using a specific combination of solvents) was invented by Kaplan

and Walker. Since these applications were filed before the Patent Law Amendments Act of 1984 (Pub. Law 98-622, § 104, November 8, 1984) amending § 116 to expressly authorize filing a patent application in the names of joint inventors which did not necessarily make a contribution to the invention defined in each claim in the patent, it was necessary to file multiple applications to claim both the broad and the narrow inventions. Accordingly, there was a valid reason why the claims to the specific solvent mixture were not presented for examination in the Kaplan patent application.

Recently, the court held that when a patentee voluntarily elects to file a continuing application to prosecute the broad genus claims, in order to obtain an allowance of a narrow species claim, the species claim precludes issuance of the generic application, absent a terminal disclaimer. *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993). In *Goodman*, the specifications of the patent and the application disclosed the invention in general terms, but provided a single working example; i.e., a method of producing gamma interferon using a DNA construct comprising an expression cassette with expression regulatory elements functional in tobacco plants (a dicotyledonous plant) and a structural gene coding for gamma-interferon. The claims the Court considered as presenting a double patenting issue were the narrow species claims in the allowed patent directed to a DNA construct comprising expression regulatory elements derived from a specific type of plasmid and which were functional in dicotyledonous plant cells and a structural gene coding for an interferon. The Court held that this type of situation did not require a "two-way" analysis because P.T.O. actions did not dictate the rate of prosecution. The patentee had the opportunity to file an immediate appeal to the courts on the genus, but instead he adopted an easier course of action by filing

a continuation application on the broad claims and obtaining issuance of the narrow genus. Although the filing dates of the patent and application were identical, the Court found that this type of situation was sufficiently analogous to a rejection under 35 U.S.C. § 102 wherein an earlier species disclosure defeats any generic claim. *Cf. Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Accordingly the Court held that a terminal disclaimer was necessary in order to prevent the patentee from gaining an unjust extension of the 17-year term on a species application when the broad genus was issued at a later date.

Each double patenting situation has to be decided on its own facts. To the extent that one would view the *Schneller* and *Kaplan* decisions to be in conflict, it is clear that *Schneller* is the controlling precedent. Decisions of a three judge panel cannot overturn prior precedential decisions. See *UMC Elec. Co. v. United States*, 816 F.2d 647, n.6, 2 USPQ 2d 1465, n.6 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1025 (1988).

Unlike statutory double patenting (§ 101), a double patenting rejection based on any non-statutory ground can be overcome by an appropriate terminal disclaimer.

As supplemental information for applicant's benefit, examiner is providing a copy of the new Chapter 800 of the MPEP regarding double patenting, and a section from *Patent and Trademark Office Day*, published December 1, 1993 which shows that non-statutory double patenting rejections were Office policy at that time.

Any inquiry concerning this communication should be directed to Linda C. M. Dvorak at telephone number (703) 308-

Appendix H

0994. In addition, facsimile transmissions concerning this application should be directed to Linda C. M. Dvorak at facsimile number (703) 305-3590.

s/ L.C.M. Dvorak
Linda C.M. Dvorak
Examiner
Art Unit 3301

LCM Dvorak
April 21, 1995

APPENDIX I — OFFICE ACTION IN REEXAMINATION ON 90/003,494 MAILED MARCH 6, 1995

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

CONTROL NUMBER	FILING DATE	PATENT UNDER REEXAMINATION	ATTORNEY DOCKET NO.
90/003494			
90/003,494	*07/11/94*	*5298013*	

EXAMINER
DVORAK, L

ART UNIT	PAPER NUMBER
3302	*8*

DATE MAILED: *03/06/95*

F3M1/0306

DONALD H. ZARLEY
ZARLEY, MCKIE, THOMTE, VOORHEES & SEASE
801 GRAND AVENUE, STE. 3200
DES MOINES, IA 50309

OFFICE ACTION IN REEXAMINATION

☒ Responsive to the communication(s) filed on *11/29/94*.

* * *

Appendix 1

A shortened statutory period for response to this action is set to expire *TWO* month(s) from the date of this letter. Failure to respond within the period for response will cause termination of the proceeding and issuance of a reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERENED BY 37 CFR 1.550(c).**

PART I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

* * *

2. ☒ Information Disclosure Citation, PTO-1449.

* * *

PART II SUMMARY OF ACTION:

1a. ☒ Claims *1-6* are subject to reexamination.

* * *

2. ☒ Claims *3, 4, 6* have been cancelled.

* * *

5. ☒ Claims *1, 2, 5* are rejected.

* * *

Appendix I

Reexamination

This reexamination is based on two issues:

(1) Whether the claims of the patent under reexamination [5,269,748] are unpatentable over Baker [3,527,209]; and

(2) Whether the claims of the patent under reexamination [5,269,748] should have been rejected under double patenting of the claims of Reissue Patent No. 33,762.

Regarding item (1), the remaining claims of the patent [claims 1, 2, and 5] are not found to be anticipated by or obvious over that of Baker and therefore no rejection regarding Baker should have been made. Baker fails to teach the claimed L-shaped member. Baker does not teach or fairly suggest, alone or in combination, a method of healing or preventing decubitus on the heel of a bedfast patient comprising placing on the leg and foot of a patient an L-shaped member having a heel portion which provides space between the patient's heel and the heel portion, and securing the L-shaped member to the leg and the foot of the patient by using a sandal extending substantially over the foot portion and the foot of the patient and cutting out a heel portion of the sandal adjacent the heel portion of the L-shaped member and the space.

Regarding item (2), a double patenting rejection should have been made and is set forth as follows.

Double Patenting

The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy

(a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re White*, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

Claims 1, 2, and 5 are rejected under the judicially created doctrine of double patenting.

The subject matter recited in claim 1 "securing said L-shaped member to the leg and the foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and cutting out a heel portion of said sandal adjacent said heel portion of said L-shaped member and said space" is fully disclosed in the prior patent to applicant [Re 33,762]. The allowance of this claim would extend the rights to exclude already granted in claim 1 of the patent. Claim 1 of the patent calls for a "means for releasably securing the device to the leg and foot of the patient". Using the specification in the patent as a dictionary of terms (*In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968)) it is found that the means are the same.

Claim 1 in Re. 33,762 provides the following coverage:

$$A_{Sp} + B_{Br}$$

where $_{Sp}$ represents "specific"
and $_{Br}$ represents "broad"

Appendix I

wherein A_{Sp} is "an L-shaped member of a flexible, transparent, acrylic, plastic, said member having a generally contoured and channel shaped leg portion, a curved heel portion integral with one end of said leg portion, and a generally contoured foot portion extending integrally from said heel portion at right angles to said leg portion, said foot portion being shorter than the adult human foot, the channel shape of said leg portion being substantially flattened at said heel portion, said curved heel portion being narrower than said leg and foot portions and having a free and unflanged edge to permit flexing of said foot portion with respect to said leg portion, said foot portion exerting a pressure of 30 to 50 lbs. toward said leg portion when said foot portion is flexed away from the right angle position"; and

B_{Br} is means for releasably securing the device to the leg and foot of a patient.

The claim or claims because of B_{Br} provides coverage not only to

$$A_{Sp} + B_{Br}$$

but also provides coverage to

$$A_{Sp} + B_{Sp}$$

and

$$A_{Br} + B_{Sp}.$$

B_{Sp} is fully disclosed in U.S. Patent Re. 33,762.

Appendix 1

The claims under rejection provide coverage to

$$A_{Br} + B_{Sp}$$

wherein A_{Br} is "placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion on one end of said leg portion, and a foot portion extending from said heel portion at right angles to said leg portion, forming the shape of said heel portion so that the shape alone of said heel portion will provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respective";

and B_{Sp} is "securing said L-shaped member to the leg and the foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and cutting out a heel portion of said sandal adjacent said heel portion of said L-shaped member and said space".

Clearly the claim provides protection already provided for by the claims of the patent.

If applicant does not come to the same conclusion as to what protection claim 1 of the patent provides as discussed above, applicant is requested to specifically point out why the examiner's conclusions are wrong.

Applicant should note that there are some unique circumstances where it has been recognized that another type of non-statutory double patenting is applicable even where the inventions claimed in two or more applications/patents are

considered non-obvious over each other. These circumstances are illustrated by the facts before the court in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

In making an analysis for this type of non-statutory double patenting the first question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is no, double patenting does not exist. If the answer is yes, as in your case, the second question is: Whether there is any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no, as in your case, a double patenting rejection is appropriate because, as stated in *Schneller*:

> . . . even a minimum concern for the public interest requires an applicant to establish that the inventions are in fact independent and distinct and hence that the grant of a patent on the later application will not result in a timewise extension of the protection afforded by his earlier patent. Failing in this, an applicant's remedy lies in filing a terminal disclaimer which will effectively prevent this result.

and further:

> Under the circumstances of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or equitable to make an exception, and wherein there is no terminal disclaimer, the rule against "double patenting" must be applied.

Appendix I

A fact situation similar to that in Schneller was presented to a Federal Circuit panel in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were tetraglyme and sulfolane. One unclaimed example in the patent was specifically directed to a mixture of these two solvents. The claims in the application to Kaplan and Walker, the application before the Office, were directed to essentially the same chemical process, but requiring the use of the solvent mixture of tetraglyme and sulfolane. In reversing the double patenting rejection, the court stated that the mere fact that the broad process claim of the patent requiring an organic solvent reads on or "dominates" the narrower claim directed to basically the same process using a specific solvent mixture does not, per se, justify a double patenting rejection. The court also pointed out that the double patenting rejection improperly used the disclosure of the joint invention (solvent mixture) in the Kaplan patent specification as though it were prior art.

A significant factor in the *Kaplan* case was that the broad invention was invented by Kaplan, and the narrow invention (i.e., using a specific combination of solvents) was invented by Kaplan and Walker. Since these applications were filed before the Patent Law Amendments Act of 1984 (Pub. Law 98-622, § 104, November 8, 1984) amending § 116 to expressly authorize filing a patent application in the names of joint inventors which did not necessarily make a contribution to the invention defined in each claim in the patent, it was necessary to file multiple applications to claim both the broad and the narrow inventions. Accordingly, there was a valid reason why the claims to the specific solvent mixture were not presented for examination in the Kaplan patent application.

Appendix I

Recently, the court held that when a patentee voluntarily elects to file a continuing application to prosecute the broad genus claims, in order to obtain an allowance of a narrow species claim, the species claim precludes issuance of the generic application, absent a terminal disclaimer. *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993). In *Goodman*, the specifications of the patent and the application disclosed the invention in general terms, but provided a single working example; i.e., a method of producing gamma interferon using a DNA construct comprising an expression cassette with expression regulatory elements functional in tobacco plants (a dicotyledonous plant) and a structural gene coding for gamma-interferon. The claims the Court considered as presenting a double patenting issue were the narrow species claims in the allowed patent directed to a DNA construct comprising expression regulatory elements derived from a specific type of plasmid and which were functional in dicotyledonous plant cells and a structural gene coding for an interferon. The Court held that this type of situation did not require a "two-way" analysis because P.T.O. actions did not dictate the rate of prosecution. The patentee had the opportunity to file an immediate appeal to the courts on the genus, but instead he adopted an easier course of action by filing a continuation application on the broad claims and obtaining issuance of the narrow genus. Although the filing dates of the patent and application were identical, the Court found that this type of situation was sufficiently analogous to a rejection under 35 U.S.C. § 102 wherein an earlier species disclosure defeats any generic claim. *Cf. Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Accordingly the Court held that a terminal disclaimer was necessary in order to prevent the patentee from gaining an unjust extension of the 17-year term on a species application when the broad genus was issued at a later date.

Each double patenting situation has to be decided on its

own facts. To the extent that one would view the *Schneller* and *Kaplan* decisions to be in conflict, it is clear that *Schneller* is the controlling precedent. Decisions of a three judge panel cannot overturn prior precedential decisions. See *UMC Elec. Co. v. United States*, 816 F.2d 647, n.6, 2 USPQ 2d 1465, n.6 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1025 (1988).

Unlike statutory double patenting (§ 101), a double patenting rejection based on any non-statutory ground can be overcome by an appropriate terminal disclaimer.

The patent under reexamination contains claims directed to a method whereas the claims in Re.33,762 are to an apparatus. The recited method is merely a recitation of placing the apparatus on the foot of the user. The specification only discloses one use for the apparatus; this use being inherent in the disclosure of the apparatus. The apparatus and method of the present invention are not considered to be patentably distinct.

Conclusion

Any inquiry concerning this communication should be directed to Linda C. M. Dvorak, Mondays, Tuesdays, Thursdays, and Fridays at telephone number (703) 308-0994. In addition, facsimile transmissions concerning this application should be directed to Linda C. M. Dvorak at facsimile number (703) 305-3590.

s/ L.C.M. Dvorak
LINDA C. M. DVORAK
EXAMINER
ART UNIT 3302

LCM Dvorak
February 27, 1995

APPENDIX J — OFFICE ACTION IN REEXAMINATION ON 90/003,494 MAILED APRIL 28, 1995

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

90/003494

CONTROL NUMBER	FILING DATE	PATENT UNDER REEXAMINATION	ATTORNEY DOCKET NO.
90/003,494	*07/11/94*	*5298013*	

EXAMINER
DVORAK, L

ART UNIT	PAPER NUMBER
3302	*10*

DATE MAILED: *04/28/95*

F3M1/0428

DONALD H. ZARLEY
ZARLEY, MCKIE, THOMTE, VOORHEES & SEASE
801 GRAND AVENUE, STE. 3200
DES MOINES, IA 50309

OFFICE ACTION IN REEXAMINATION

☒ Responsive to the communication(s) filed on *3/2/95*.
☒ This action is made FINAL.

Appendix J

A shortened statutory period for response to this action is set to expire *TWO* month(s) from the date of this letter. Failure to respond within the period for response will cause termination of the proceeding and issuance of a reexamination certificate in accordance with this action. 37 CFR 1.550(d). **EXTENSIONS OF TIME ARE GOVERENED BY 37 CFR 1.550(c).**

PART I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

* * *

4. ☒ *Pages 1-20 PTO Day of 12/1/93 Chapter 800 of MPEP*

PART II SUMMARY OF ACTION:

1a. ☒ Claims *1-6* are subject to reexamination.

* * *

2. ☒ Claims *3, 4, 6* have been cancelled.

* * *

5. ☒ Claims *1, 2, 5* are rejected.

* * *

Appendix J

Double Patenting

The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re White*, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

Claims 1, 2, and 5 are rejected under the judicially created doctrine of double patenting.

The subject matter recited in claim 1 "securing said L-shaped member to the leg and the foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and cutting out a heel portion of said sandal adjacent said heel portion of said L-shaped member and said space" is fully disclosed in the prior patent to applicant [Re 33,762]. The allowance of this claim would extend the rights to exclude already granted in claim 1 of the patent. Claim 1 of the patent calls for a "means for releasably securing the device to the leg and foot of the patient". Using the specification in the patent as a dictionary of terms (*In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968)) it is found that the means are the same.

Claim 1 in Re. 33,762 provides the following coverage:

Appendix J

$A_{Sp} + B_{Br}$

where $_{Sp}$ represents "specific"
and $_{Br}$ represents "broad"

wherein A_{Sp} is "an L-shaped member of a flexible, transparent, acrylic, plastic, said member having a generally contoured and channel shaped leg portion, a curved heel portion integral with one end of said leg portion, and a generally contoured foot portion extending integrally from said heel portion at right angles to said leg portion, said foot portion being shorter than the adult human foot, the channel shape of said leg portion being substantially flattened at said heel portion, said curved heel portion being narrower than said leg and foot portions and having a free and unflanged edge to permit flexing of said foot portion with respect to said leg portion, said foot portion exerting a pressure of 30 to 50 lbs. toward said leg portion when said foot portion is flexed away from the right angle position"; and

B_{Br} is means for releasably securing the device to the leg and foot of a patient.

The claim or claims because of B_{Br} provides coverage not only to

$A_{Sp} + B_{Br}$

but also provides coverage to

$A_{Sp} + B_{Sp}$

and

$A_{Sp} + B_{Sp}$.

B_{Sp} is fully disclosed in U.S. Patent Re. 33,762.

Appendix J

The claims under rejection provide coverage to

$$A_{Br} + B_{Sp}$$

wherein A_{Br} is "placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion on one end of said leg portion, and a foot portion extending from said heel portion at right angles to said leg portion, forming the shape of said heel portion so that the shape alone of said heel portion will provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respective";

and B_{Sp} is "securing said L-shaped member to the leg and the foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and cutting out a heel portion of said sandal adjacent said heel portion of said L-shaped member and said space".

Clearly the claim provides protection already provided for by the claims of the patent.

If applicant does not come to the same conclusion as to what protection claim 1 of the patent provides as discussed above, applicant is requested to specifically point out why the examiner's conclusions are wrong.

Response to Arguments

Patentee in his description of double patenting states that there are only two types — same invention and obviousness.

Appendix J

Patentee is correct in his statement that there are only two types, but is incorrect in listing obviousness type as one. There are two types and they are statutory and non-statutory. Non-statutory is the generic term that encompasses both obvious and non-obvious types. All non-statutory double patenting rejections, whether they are based on an obvious variation of the patented invention or not, have been classified in the past as "obvious-type double patenting" rejections. As the court stated in Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982):

> This latter classification (obvious type double patenting) has, in the course of time, come somewhat loosely to indicate any "double patenting" situation other than one of "same invention" (35 USC 101) type.

In order to distinguish the various non-statutory double patenting situations, the phrase "obviousness type double patenting" will not be used herein unless an obviousness analysis is necessary to support the double patenting rejection.

Further, applicant is incorrect when he states that Schneller was another type of obviousness type double patenting. The Court in Schneller specifically states that Schneller was not of the obviousness type, and Van Ornam reaffirms the principles of Schneller.

As to applicant's arguments concerning domination, domination and double patenting should not be confused. They are two separate issues. "Domination" occurs when one patent has a broad or generic claim which reads on an invention defined in a narrower or more specific claim in another application, and thus dominates the more narrow or specific claim. More simply put, one patent dominates another if a claim of the first patent

reads on a device built or process practiced according to the second patent disclosure. Domination, by itself, does not give rise to double patenting. *In re Sarett*, 327 F.2d 2005, 140 USPQ 474, 482 (CCPA 1964) and *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678, 681 (Fed. Cir. 1986).

Additionally, there are some unique circumstances where it has been recognized that another type of non-statutory double patenting is applicable even where the inventions claimed in two or more applications/patents are considered non-obvious over each other. These circumstances are illustrated by the facts before the court in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

In making an analysis for this type of non-statutory double patenting the first question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is no, double patenting does not exist. If the answer is yes, as in your case, the second question is: Whether there is any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no, as in your case, a double patenting rejection is appropriate because, as stated in *Schneller*:

> . . . even a minimum concern for the public interest requires an applicant to establish that the inventions are in fact independent and distinct and hence that the grant of a patent on the later application will not result in a timewise extension of the protection afforded by his earlier patent. Failing in this, an applicant's remedy lies in filing a terminal

> disclaimer which will effectively prevent this result.

and further:

> Under the circumstances of the instant case, wherein we find no valid excuse or mitigating circumstances making it either reasonable or equitable to make an exception, and wherein there is no terminal disclaimer, the rule against "double patenting" must be applied.

A fact situation similar to that in Schneller was presented to a Federal Circuit panel in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were tetraglyme and sulfolane. One unclaimed example in the patent was specifically directed to a mixture of these two solvents. The claims in the application to Kaplan and Walker, the application before the Office, were directed to essentially the same chemical process, but requiring the use of the solvent mixture of tetraglyme and sulfolane. In reversing the double patenting rejection, the court stated that the mere fact that the broad process claim of the patent requiring an organic solvent reads on or "dominates" the narrower claim directed to basically the same process using a specific solvent mixture does not, per se, justify a double patenting rejection. The court also pointed out that the double patenting rejection improperly used the disclosure of the joint invention (solvent mixture) in the Kaplan patent specification as though it were prior art.

Appendix J

A significant factor in the *Kaplan* case was that the broad invention was invented by Kaplan, and the narrow invention (i.e., using a specific combination of solvents) was invented by Kaplan and Walker. Since these applications were filed before the Patent Law Amendments Act of 1984 (Pub. Law 98-622, § 104, November 8, 1984) amending § 116 to expressly authorize filing a patent application in the names of joint inventors which did not necessarily make a contribution to the invention defined in each claim in the patent, it was necessary to file multiple applications to claim both the broad and the narrow inventions. Accordingly, there was a valid reason why the claims to the specific solvent mixture were not presented for examination in the Kaplan patent application.

Recently, the court held that when a patentee voluntarily elects to file a continuing application to prosecute the broad genus claims, in order to obtain an allowance of a narrow species claim, the species claim precludes issuance of the generic application, absent a terminal disclaimer. *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993). In *Goodman*, the specifications of the patent and the application disclosed the invention in general terms, but provided a single working example; i.e., a method of producing gamma interferon using a DNA construct comprising an expression cassette with expression regulatory elements functional in tobacco plants (a dicotyledonous plant) and a structural gene coding for gamma-interferon. The claims the Court considered as presenting a double patenting issue were the narrow species claims in the allowed patent directed to a DNA construct comprising expression regulatory elements derived from a specific type of plasmid and which were functional in dicotyledonous plant cells and a structural gene coding for an interferon. The Court held that this type of situation did not require a "two-way" analysis because P.T.O. actions did

not dictate the rate of prosecution. The patentee had the opportunity to file an immediate appeal to the courts on the genus, but instead he adopted an easier course of action by filing a continuation application on the broad claims and obtaining issuance of the narrow genus. Although the filing dates of the patent and application were identical, the Court found that this type of situation was sufficiently analogous to a rejection under 35 U.S.C. § 102 wherein an earlier species disclosure defeats any generic claim. *Cf. Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir 1985). Accordingly the Court held that a terminal disclaimer was necessary in order to prevent the patentee from gaining an unjust extension of the 17-year term on a species application when the broad genus was issued at a later date.

Each double patenting situation has to be decided on its own facts. To the extent that one would view the *Schneller* and *Kaplan* decisions to be in conflict, it is clear that *Schneller* is the controlling precedent. Decisions of a three judge panel cannot overturn prior precedential decisions. See *UMC Elec. Co. v. United States*, 816 F.2d 647, n.6, 2 USPQ 2d 1465, n.6 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1025 (1988).

Unlike statutory double patenting (§ 101), a double patenting rejection based on any non-statutory ground can be overcome by an appropriate terminal disclaimer.

As supplemental information for applicant's benefit, examiner is providing a copy of the new Chapter 800 of the MPEP regarding double patenting, and a section from *Patent and Trademark Office Day*, published December 1, 1993 which shows that non-statutory double patenting rejections were Office policy at that time.

Appendix J

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.550(c).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE TWO MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Linda C. M. Dvorak, Mondays, Tuesdays, Thursdays, and Fridays at telephone number (703) 308-0994. In addition, facsimile transmissions concerning this application should be directed to Linda C. M. Dvorak at facsimile number (703) 305-3590.

s/ L.C.M. Dvorak
LINDA C. M. DVORAK
EXAMINER
ART UNIT 3302

LCM Dvorak
April 21, 1995

APPENDIX K — FINAL OFFICE ACTION ON 08/218,756 MAILED APRIL 26, 1995

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

08/218756

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/218,756	*03/28/94*	*LONARDO R*	

EXAMINER
DVORAK, L

ART UNIT	PAPER NUMBER
3302	*17*

DATE MAILED: *04/26/95*

F3M1/0426

DONALD H. ZARLEY
ZARLEY, MCKEE, THOMTE, VOORHEES & SEASE
SUITE 3200, 801 GRAND AVENUE
DES MOINES, IOWA 50309-2721

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on *3/2/95* ☒ This action is made final.

Appendix K

A shortened statutory period for response to this action is set to expire *THREE* month(s) from the date of this letter. Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

* * *

6. ☒ *Chapter 800 MPEP; Pages 1-20 PTO Day 12/1/93.*

* * *

Part II SUMMARY OF ACTION:

1. ☒ Claim *1 is* pending in the application.

* * *

4. ☒ Claim *1 is* rejected.

* * *

Appendix K

Double Patenting

The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re White*, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

Claim 1 is rejected under the judicially created doctrine of double patenting.

The subject matter recited in claim 1 "securing said L-shaped member to the leg and the foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and cutting out a heel portion of said sandal adjacent said heel portion of said L-shaped member and said space" is fully disclosed in the prior patent to applicant [Re 33,762]. The allowance of this claim would extend the rights to exclude already granted in claim 1 of the patent. Claim 1 of the patent calls for a "means for releasably securing the device to the leg and foot of the patient". Using the specification in the patent as a dictionary of terms (*In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) and *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968)) it is found that the means are the same.

Claim 1 in Re. 33,762 provides the following coverage:

Appendix K

$A_{Sp} + B_{Br}$

where $_{Sp}$ represents "specific"
and $_{Br}$ represents "broad"

wherein A_{Sp} is "an L-shaped member of a flexible, transparent, acrylic, plastic, said member having a generally contoured and channel shaped leg portion, a curved heel portion integral with one end of said leg portion, and a generally contoured foot portion extending integrally from said heel portion at right angles to said leg portion, said foot portion being shorter than the adult human foot, the channel shape of said leg portion being substantially flattened at said heel portion, said curved heel portion being narrower than said leg and foot portions and having a free and unflanged edge to permit flexing of said foot portion with respect to said leg portion, said foot portion exerting a pressure of 30 to 50 lbs. toward said leg portion when said foot portion is flexed away from the right angle position"; and

B_{Br} is means for releasably securing the device to the leg and foot of a patient.

The claim or claims because of B_{Br} provides coverage not only to

$A_{Sp} + B_{Br}$

but also provides coverage to

$A_{Sp} + B_{Sp}$

and

$A_{Br} + B_{Sp}$.

B_{Sp} is fully disclosed in U.S. Patent Re. 33,762.

Appendix K

The claims under rejection provide coverage to

$$A_{Br} + B_{Sp}$$

wherein A_{Br} is "placing on the leg and foot of said patient an L-shaped member having a leg portion, a heel portion on one end of said leg portion, and a foot portion extending from said heel portion at right angles to said leg portion, forming the shape of said heel portion so that the shape alone of said heel portion will provide a space between the patient's heel and said heel portion to prevent the application of pressure to the patient's heel by said heel portion when the lower leg and the sole of the foot of said patient are in intimate contact with said leg portion and said foot portion, respective";

and B_{Sp} is "securing said L-shaped member to the leg and the foot of said patient by using a sandal extending substantially over said foot portion and the foot of the patient, and cutting out a heel portion of said sandal adjacent said heel portion of said L-shaped member and said space".

Clearly the claim provides protection already provided for by the claims of the patent.

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Patentee in his description of double patenting states that there are only two types — same invention and obviousness. Patentee is correct in his statement that there are only two types, but is incorrect in listing obviousness type as one. There are two types and they are statutory and non-statutory. Non-statutory is the generic term that encompasses both obvious and non-obvious types. All non-statutory double patenting rejections,

whether they are based on an obvious variation of the patented invention or not, have been classified in the past as "obvious-type double patenting" rejections. As the court stated in Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982):

This latter classification (obvious type double patenting) has, in the course of time, come somewhat loosely to indicate any "double patenting" situation other than one of "same invention" (35 USC 101) type.

In order to distinguish the various non-statutory double patenting situations, the phrase "obviousness type double patenting" will not be used herein unless an obviousness analysis is necessary to support the double patenting rejection.

Further, applicant is incorrect when he states that Schneller was another type of obviousness type double patenting. The Court in Schneller specifically states that Schneller was not of the obviousness type, and Van Ornam reaffirms the principles of Schneller.

As to applicant's arguments concerning domination, domination and double patenting should not be confused. They are two separate issues. "Domination" occurs when one patent has a broad or generic claim which reads on an invention defined in a narrower or more specific claim in another application, and thus dominates the more narrow or specific claim. More simply put, one patent dominates another if a claim of the first patent reads on a device built or process practiced according to the second patent disclosure. Domination, by itself, does not give rise to double patenting. *In re Sarett*, 327 F.2d 2005, 140 USPQ 474, 482 (CCPA 1964) and *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678, 681 (Fed. Cir. 1986).

Appendix K

Additionally, there are some unique circumstances where it has been recognized that another type of non-statutory double patenting is applicable even where the inventions claimed in two or more applications/patents are considered non-obvious over each other. These circumstances are illustrated by the facts before the court in *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

In making an analysis for this type of non-statutory double patenting the first question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is no, double patenting does not exist. If the answer is yes, as in your case, the second question is: Whether there is any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no, as in your case, a double patenting rejection is appropriate because, as stated in *Schneller*:

> . . . even a minimum concern for the public interest requires an applicant to establish that the inventions are in fact independent and distinct and hence that the grant of a patent on the later application will not result in a timewise extension of the protection afforded by his earlier patent. Failing in this, an applicant's remedy lies in filing a terminal disclaimer which will effectively prevent this result.

and further:

> Under the circumstances of the instant case,

> wherein we find no valid excuse or mitigating circumstances making it either reasonable or equitable to make an exception, and wherein there is no terminal disclaimer, the rule against "double patenting" must be applied.

A fact situation similar to that in Schneller was presented to a Federal Circuit panel in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were tetraglyme and sulfolane. One unclaimed example in the patent was specifically directed to a mixture of these two solvents. The claims in the application to Kaplan and Walker, the application before the Office, were directed to essentially the same chemical process, but requiring the use of the solvent mixture of tetraglyme and sulfolane. In reversing the double patenting rejection, the court stated that the mere fact that the broad process claim of the patent requiring an organic solvent reads on or "dominates" the narrower claim directed to basically the same process using a specific solvent mixture does not, per se, justify a double patenting rejection. The court also pointed out that the double patenting rejection improperly used the disclosure of the joint invention (solvent mixture) in the Kaplan patent specification as though it were prior art.

A significant factor in the *Kaplan* case was that the broad invention was invented by Kaplan, and the narrow invention (i.e., using a specific combination of solvents) was invented by Kaplan and Walker. Since these applications were filed before the Patent Law Amendments Act of 1984 (Pub. Law 98-622, § 104, November 8, 1984) amending § 116 to expressly authorize filing

a patent application in the names of joint inventors which did not necessarily make a contribution to the invention defined in each claim in the patent, it was necessary to file multiple applications to claim both the broad and the narrow inventions. Accordingly, there was a valid reason why the claims to the specific solvent mixture were not presented for examination in the Kaplan patent application.

Recently, the court held that when a patentee voluntarily elects to file a continuing application to prosecute the broad genus claims, in order to obtain an allowance of a narrow species claim, the species claim precludes issuance of the generic application, absent a terminal disclaimer. *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993). In *Goodman*, the specifications of the patent and the application disclosed the invention in general terms, but provided a single working example; i.e., a method of producing gamma interferon using a DNA construct comprising an expression cassette with expression regulatory elements functional in tobacco plants (a dicotyledonous plant) and a structural gene coding for gamma-interferon. The claims the Court considered as presenting a double patenting issue were the narrow species claims in the allowed patent directed to a DNA construct comprising expression regulatory elements derived from a specific type of plasmid and which were functional in dicotyledonous plant cells and a structural gene coding for an interferon. The Court held that this type of situation did not require a "two-way" analysis because P.T.O. actions did not dictate the rate of prosecution. The patentee had the opportunity to file an immediate appeal to the courts on the genus, but instead he adopted an easier course of action by filing a continuation application on the broad claims and obtaining issuance of the narrow genus. Although the filing dates of the patent and application were identical, the Court found that this

type of situation was sufficiently analogous to a rejection under 35 U.S.C. § 102 wherein an earlier species disclosure defeats any generic claim. *Cf. Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985). Accordingly the Court held that a terminal disclaimer was necessary in order to prevent the patentee from gaining an unjust extension of the 17-year term on a species application when the broad genus was issued at a later date.

Each double patenting situation has to be decided on its own facts. To the extent that one would view the *Schneller* and *Kaplan* decisions to be in conflict, it is clear that *Schneller* is the controlling precedent. Decisions of a three judge panel cannot overturn prior precedential decisions. See *UMC Elec. Co. v. United States*, 816 F.2d 647, n.6, 2 USPQ 2d 1465, n.6 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 1025 (1988).

Unlike statutory double patenting (§ 101), a double patenting rejection based on any non-statutory ground can be overcome by an appropriate terminal disclaimer.

As supplemental information for applicant's benefit, examiner is providing a copy of the new Chapter 800 of the MPEP regarding double patenting, and a section from *Patent and Trademark Office Day*, published December 1, 1993 which shows that non-statutory double patenting rejections were Office policy at that time.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.550(c).

Appendix K

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE TWO MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Linda C. M. Dvorak, Mondays, Tuesdays, Thursdays, and Fridays at telephone number (703) 308-0994. In addition, facsimile transmissions concerning this application should be directed to Linda C. M. Dvorak at facsimile number (703) 305-3590.

s/ L.C.M. Dvorak
LINDA C. M. DVORAK
EXAMINER
ART UNIT 3302

LCM Dvorak
April 24, 1995

APPENDIX L — RELEVANT STATUTES

35 U.S.C. §§ 301-304

§ 301 Citation of prior art

Any person at any time may cite to the Office in writing prior art consisting of patents or printed publications which that person believes to have a bearing on the patentability of any claim of a particular patent. If the person explains in writing the pertinency and manner of applying such prior art to at least one claim of the patent, the citation of such prior art and the explanation thereof will become a part of the official file of the patent. At the written request of the person citing the prior art, his or her identity will be excluded from the patent file and kept confidential.

(Dec. 12, 1980, Pub. L. 96-517, §1, 94 Stat. 3015.)

§ 302 Request for reexamination

Any person at any time may file a request for reexamination by the Office of any claim of a patent on the basis of any prior art cited under the provisions of section 301 of this title. The request must be in writing and must be accompanied by payment of a reexamination fee established by the Commissioner of Patents pursuant to the provisions of section 41 of this title. The request must set forth the pertinency and manner of applying cited prior art to every claim for which reexamination is requested. Unless the requesting person is the owner of the patent, the Commissioner promptly will send a copy of the request to the owner of record of the patent.

(Dec. 12, 1980, Pub. L. 96-517, §1, 94 Stat. 3015.)

Appendix L

§ 303 Determination of issue by Commissioner

(a) Within three months following the filing of a request for reexamination under the provisions of section 302 of this title, the Commissioner will determine whether a substantial new question of patentability affecting any claim of the patent concerned is raised by the request, with or without consideration of other patents or printed publications. On his own initiative, and any time, the Commissioner may determine whether a substantial new question of patentability is raised by patents and publications discovered by him or cited under the provisions of section 301 of this title.

(b) A record of the Commissioner's determination under subsection (a) of this section will be placed in the official file of the patent, and a copy promptly will be given or mailed to the owner of record of the patent and to the person requesting reexamination, if any.

(c) A determination by the Commissioner pursuant to subsection (a) of this section that no substantial new question of patentability has been raised will be final and nonappealable. Upon such a determination, the Commissioner may refund a portion of the reexamination fee required under section 302 of this title.

(Dec. 12, 1980, Pub. L. 96-517, §1, 94 Stat. 3015.)

§ 304 Reexamination order by Commissioner

If, in a determination made under the provisions of subsection 303(a) of this title, the Commissioner finds that a substantial new question of patentability affecting any claim of a patent is

raised, the determination will include an order for reexamination of the patent for resolution of the question. The patent owner will be given a reasonable period, not less than two months from the date a copy of the determination is given or mailed to him, within which he may file a statement on such question, including any amendment to his patent and new claim or claims he may wish to propose, for consideration in the reexamination. If the patent owner files such a statement, he promptly will serve a copy of it on the person who has requested reexamination under the provisions of section 302 of this title. Within a period of two months from the date of service, that person may file and have considered in the reexamination a reply to any statement filed by the patent owner. That person promptly will serve on the patent owner a copy of any reply filed.

(Dec. 12, 1980, Pub. L. 96-517, §1, 94 Stat. 3016.)

APPENDIX M — REEXAMINATION FILING DATA DATED JUNE 30, 1997

UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
ASSISTANT SECRETARY AND COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

Reexamination Filing Data — June 30, 1997

1. Total requests filed since start of reexam on 7/1/81 .. 4677

a. By patent owner	1970	42%
b. By other member of public	2621	56%
c. By order of Commissioner	86	2%

2. Number of filings by discipline

a. Chemical Operation	1478	32%
b. Electrical Operation	1582	34%
c. Mechanical Operation	1617	34%

3. Monthly Reexam Filings (FY 1997)

Month	No.	Month	No.	Month	No.
Oct 1996	45	Feb 1997	36	Jun 1997	25
Nov 1996	33	Mar 1997	21	Jul 1997	—
Dec 1996	27	Apr 1997	30	Aug 1997	—
Jan 1997	32	May 1997	31	Sep 1997	—

Appendix M

4. Annual Reexam Filings

Fiscal Yr.	No.	Fiscal Yr.	No.	Fiscal Yr.	No.
1981	78(3mos.)	1987	240	1993	359
1982	187	1988	268	1994	379
1983	186	1989	243	1995	392
1984	189	1990	297	1996	418
1985	230	1991	307	1997	280 (YTD)
1986	232	1992	392		

5. Number known to be in litigation 933 20%

6. Total no. involved in interference 37 1%

7. Reexam conducted by original examiner

Total certificates issued..... 3242

a. Yes (same examiner) 1692 52%
b. No (different examiner) 1550 48%

8. Determinations on requests 4540

a. No. granted ..... 4058 ..... 89%

(1) By examiner 3968
(2) By Director (on petition) 90

b. No. denied ..... 482 ..... 11%

(1) By examiner 457
(2) Order vacated 25

Appendix M

9. Total examiner denials 547
Includes denials reversed by Director [8a(2)+8b(1)]

a. Requester identity

(1) Patent owner requester	311	57%
(2) Third party requester	236	43%

b. Denial by original or different examiner

(1) Original examiner	403	74%
(2) Different examiner	144	26%

10. Initial denial reversed by Director 90

a. Original examiner	73	81%
b. Different examiner	17	19%

11. Total reexamination certificates issued 3242

12. Overall reexamination pendency (Filing date to certificate issue date)

a. Average pendency	19.0 (mos.)
b. Median pendency	15.2 (mos.)

13. Reexam certificate claim status

Total certificates issued 3242

a. Certificates with all claims confirmed	797	24%
b. Certificates with all claims canceled	348	11%
c. Certificates with claims changes	2097	65%

Appendix M

14. Reexam claim analysis

	Same Exmr.	Diff. Exmr.	Overall
a. All claims confirmed	25%	24%	24%
b. All claims canceled	10%	12%	11%
c. Claim changes	65%	64%	65%

	Owner Re-quester	3rd Party Re-quester	Comm'r Initi-ated	Overall
d. All claims confirmed	19%	29%	18%	24%
e. All claims cancelled	8%	13%	15%	11%
f. Claims changes	73%	58%	67%	65%

15. Reexam claim analysis — reexam conducted by original or different examiner

a. Certificates — ORIGINAL EXAMINER 1692

(1) All claims confirmed	427	25%
(2) All claims canceled	162	10%
(3) Claim changes	1103	65%

b. Certificates — DIFFERENT EXAMINER.. 1550

(1) All claims confirmed	368	24%
(2) All claims canceled	190	12%
(3) Claim changes	992	64%

c. Total certificates issued 3242

Appendix M

16. Reexam claim analysis — requester is patent owner or 3rd party, or Comm'r initiated.

a. Certificates — PATENT OWNER REQUESTER . 1389

(1) All claims confirmed	264	19%
(2) All claims canceled	113	8%
(3) Claim changes	1012	73%

b. Certificates — 3rd PARTY REQUESTER 1777

(1) All claims confirmed	517	29%
(2) All claims canceled	228	13%
(3) Claim changes	1032	58%

c. Certificates — COMM'R INITIATED REEXAM 76

(1) All claims confirmed	14	18%
(2) All claims canceled	11	15%
(3) Claim changes	51	67%

APPENDIX N — PATENT AND TRADEMARK LAWS

LEGISLATIVE HISTORY
P.L. 96-517

PATENT AND TRADEMARK LAWS

P.L. 96-517, Rec. page 94 Stat. 3015

House Report (Judiciary Committee) No. 96-1307(I)
Sept. 9, 1980 [To accompany H.R. 6933]

House Report (Government Operations Committee) No. 96-1307(II), Sept. 23, 1980 [To accompany H.R. 6933]

Cong. Record Vol. 126 (1980)

DATES OF CONSIDERATION AND PASSAGE

House November 17, 21, 1980

Senate November 20, 1980

No Senate Report was submitted with this legislation.

HOUSE REPORT NO. 96-1307, PART 1

The Committee on the Judiciary to whom was referred the bill (H.R. 6933) entitled: "To amend the patent and trademark laws", having considered the same, report favorably thereon with amendments and recommend that the bill as amended do pass.

* * * * * * * * * *

Appendix N

STATEMENT

THE NEED FOR THE LEGISLATION

Many analysts of the U.S. economy have warned that the roots of the current recession lie in a longer term economic malaise which arises out a failure of American industry to keep pace with the increased productivity of foreign competitors.[1]

According to the Committee of Economic Development, "the slowing of productivity improvement during the past few years parallels the discouraging decline in the rate of investment in plant and equipment."[2] The rate of investment as a proportion of GNP has averaged about one half the rate for France and Germany and about one third the rate for Japan. Further, the situation does not appear to be improving. There has been an especially significant decline in total U.S. expenditures for research and development, as measured in constant dollars since 1970.[3] Since the primary means of improving productivity lies in the creation of new technologies, the decline in expenditures for research and development is especially significant to the health of the overall economy.

Testimony presented to the Subcommittee on Courts, Civil Liberties and the Administration of Justice also indicates that

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1. Report of the President's advisory Committee on Industrial Innovation, Sept. 1979.

2. *Stimulating Technological Progress.* A statement by the Research and Policy Committee of the Committee for Economic Development, Jan. 1980, pp. 2-7.

3. *Science Indicators.* National Science Board, 1976, pp. 108-115.

the Federal Government is bearing an ever increasing share of the burden of financing basic research and development.[4] This means that the effective commercialization of government financed research is becoming an ever more important issue for those who are concerned with industrial innovation. The patent policies governing the utilization of government funded research will become even more important when the research expected to flow out of recent Congressional enactments such as the Energy Security Act of 1980[5] begins to produce usable new technologies. It is highly likely that the fuel which powers our automobiles and the boilers which heat our homes will owe part of their chemical composition or mechanical operation to patented research developed in part by government funds. At the present time U.S. companies desiring to use government funded research to develop new products and processes must confront a bewildering array of 26 different sets of agency regulations governing their rights to use such research. This bureaucratic confusion discourages efficient use of taxpayer financed research and development.

HISTORY OF THE BILL

The crisis in U.S. productivity and the governmental role in it has not gone unnoticed, however. In May of 1978 the President called for a major policy review of industrial innovation as the key to increased productivity in the United States. This White House call to action resulted in the creation of an advisory Committee of more than 150 senior

4. Testimony of Pindaros Roy Vagelos, M.D., before the subcommittee on Courts, Civil Liberties and the Administration of Justice April 15, 1980, transcript p. 14.

5. P.L. 96-294.

representatives from the industrial, public interest, labor, scientific, and academic communities. The work of the Advisory Committee was overseen by a cabinet level coordinating committee chaired by the Secretary of Commerce. The Committee studied all the areas in which federal government policy impacts on productivity and innovation in the private sector. These fields of inquiry included: economic and trade policy; environmental, health and safety regulations; anti-trust enforcement; federal procurement policies, and federal patent and information policies.

When the advisory committee issued its 300 page report last year, a key segment contained recommendations on government patent policy. These recommendations, in turn, were received by the President, and formed the basis of a major legislative proposal which was conveyed to the Congress. Special emphasis was placed on the role of the patent system and the patent policy regarding government funded research in promoting industrial innovation. These patent related recommendations were forwarded to the Committee on the Judiciary and are embodied in H.R. 6933 and H.R. 3806.

H.R. 6933 has three major thrusts. First, it strengthens investor confidence in the certainty of patent rights by creating a system of administrative reexamination of doubtful patents. Secondly, it strengthens the financial resources of the Patent Office to provide fast and accurate processing of patent applications by revising the fee structure of the Office. Finally, the existing melange of 26 different agency policies on vesting of patent rights in government funded research is replaced by a single, uniform national policy designed to cut down on bureaucracy and encourage private industry to utilize government funded inventions through the commitment of the

risk capital necessary to develop such inventions to the point of commercial application.

H.R. 3806 embodies another recommendation of the Advisory Committee and the President. It grants jurisdiction over appeals in patent cases to a single court of appeals — ending the current legal confusion created by 11 different appellate forums, all generating different interpretations of the patent law. The new court will do a great deal to improve investors confidence in patented technology.

In addition to the three broad areas already outlined, H.R. 6933 addresses the special needs of Universities and small businesses when they attempt to deal with patent issues arising out of government contracts. Both of these groups lack the resources to cope with the bewildering regulatory and bureaucratic problems associated with transfer of patent rights pursuant to government contracts; and the university sector in particular is an important link to the private sector.

The Subcommittee on Courts, Civil Liberties and the Administration of Justice held seven days of hearings on H.R. 6933 and related patent law proposals. In all, over thirty witnesses from Government, the private Bar, industry, education, small business, and the judiciary offered testimony on the various legislative proposals before the subcommittee. Hearings were followed by four days of markup, during which H.R. 3806, creating a new Court of Appeals for the Federal Circuit, H.R. 6933, containing reforms in patent policy and procedures, and H.R. 6934, clarifying the law of copyright of computer programs, were reported favorably. Each bill was reported unanimously. The unanimous votes, particularly on H.R. 6933, were cast only after careful examination of the legislation in light of the

criticisms made during the hearings and after consultation with members of the Committee on Science and Technology, which shares jurisdictional interest. During the course of markup H.R. 6933 was amended substantially to respond to criticisms raised during the hearing.

SUMMARY OF THE BILL

H.R. 6933, as amended, addresses four major issues. Section 1 provides for a system of administrative reexamination of patents within the patent office. This new procedure will permit any party to petition the patent office to review the efficacy of a patent, subsequent to its issuance, on the basis of new information about preexisting technology which may have escaped review at the time of the initial examination of the patent application. Reexamination will permit efficient resolution of questions about the validity of issued patents without recourse to expensive and lengthy infringement litigation. This, in turn, will promote industrial innovation by assuring the kind of certainty about patent validity which is a necessary ingredient of sound investment decisions.

The cost incurred in defensive patent litigation sometimes reaches $250,000 for each party, an impossible burden for many smaller firms. The result is a chilling effect on those businesses and independent inventors who have repeatedly demonstrated their ability to successfully innovate and develop new products. A new patent reexamination procedure is needed to permit the owner of a patent to have the validity of his patent tested in the Patent office where the most expert opinions exist and at a much reduced cost. Patent office reexamination will greatly reduce, if not end, the threat of legal costs being used to "blackmail" such holders into allowing patent infringements or being forced to license their patents for nominal fees.

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The reexamination of issued patents could be conducted with a fraction of the time and cost of formal legal proceedings and would help restore confidence in the effectiveness of our patent system.

The bill does not provide for a stay of court proceedings. It is believed by the committee that stay provisions are unnecessary in that such power already resides with the Court to prevent costly pretrial maneuvering which attempts to circumvent the reexamination procedure. It is anticipated that these measures provide a useful and necessary alternative for challengers and for patent owners to test the validity of United States patents in an efficient and relatively inexpensive manner.

Sections 2 through 5 of H.R. 6933 provide for a new fee structure for the patent office. At the present time patent examination fees are established by statute, last revised in 1967. When enacted, the present fee structure provided revenues which met 67 percent of the costs of operating the Patent Office. Inflation has now reduced the impact of those fees to the point where they generate only 27 percent of the funding necessary to the operation of the office.

At the present time patent fees average about $239 per application.[6]

H.R. 6933 would entirely revise the fee structure. It grants the Commissioner the power to establish fees. As introduced, the bill provided that the fee level would be revised yearly to generate 60 percent of the revenue needed to operate the office. However, the subcommittee amended the bill to reduce that level

6. Testimony of Honorable Sidney Diamond, Commissioner of Patents, April 24, 1980 — p. 50.

to 50 percent. This was in response particularly to criticism from small business and individual inventors that the fees would place too great a burden on those groups.

In order further to soften the impact on small business and individual inventors, the fees are to be paid in four installments over the life of the patent. This system, known as maintenance fees, is in use in most advanced industrial nations and has the advantage of deferring payment until the invention begins to return revenue to the inventor.

Should the invention prove to have no commercial value, the inventor has the option of permitting the patent to lapse, thus avoiding all further fees.

Section 6 of H.R. 6933 provides for a uniform policy governing the disposition of patent rights in government funded research. This would replace the 26 different agency policies now in effect. There are two patent policies provided in this section. Non-profit research institution and small businesses are given preferential treatment. The legislation establishes a presumption that ownership of all patent rights in government funded research will vest in any contractor who is a non-profit research institution or a small business. This portion of H.R. 6933 substantially incorporates legislation separately introduced, H.R. 2414 (S. 414), entitled the University, Small Business Patent Policy Act.

Large businesses are governed by a separate policy. They receive exclusive licenses for specific uses they intend to commercialize. As with small business and universities, here too the presumption lies with the granting of exclusive rights to the Contractor.

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Critics of the bill testified that it would be impossible for a contractor to determine in good faith his ability to commercialize in a particular field of use at the time of disclosure of the invention.

As a result and for the purposes of foreign patent rights, the sub-committee approved an amendment which grants temporary title to a contractor for up to four and one half years before requiring him to specify his fields of use. This provides for more flexibility for the contractor while at the same time protecting the taxpaying public because:

1. The government, not the contractor, will obtain ownership of patent rights to contract inventions.

2. The government will permit contractors to obtain exclusive licenses but only for fields of use in which they intend to commercialize a patented invention.

3. The government has the right to deny the transfer of exclusive rights for any field of use within 90 days of the contractor's disclosure of a field or fields of use he intends to commercialize.

4. Public interest antitrust and national security standards are to be applied by the government in making such determination whether to deny an exclusive license.

From a contractor point of view, the amendment offers many of the advantages of patent ownership, including full title abroad and the right to sublicense domestically.

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From an innovation point of view, the requirement that exclusive licenses be limited to specified fields of use that the contractor intends to commercialize should prevent sitting on technology, and spur innovation.

Some contractors, particularly in the defense area, will lose some rights which they presently receive through full waiver. However, the overwhelming number of contractors will receive faster, more efficient treatment under these provisions. For example, delays in acting on patent right waiver requests, which now take on the average a year and a half in agencies like the Department of Energy, will be eliminated. Contractors will know their rights with certainty within 90 days of identifying a specific field of use under a patent to a government financed invention.

In developing the amendment to this section, it should be noted that the subcommittee worked closely with the Science and Technology Committee, and it is particularly grateful to members of that Committee for their contributions.

Finally, sections 9 and 10 of the bill, as reported by the subcommittee, reflect amendments which are designed to respond to the criticism of witnesses who argued both that the Patent Office ought to be independent of the Department of Commerce and that the present search files of the Office fail to effectively utilize modern computer technology.

SECTION-BY-SECTION ANALYSIS

REEXAMINATION

Section 1 of the bill would add seven new sections to the patent laws to establish a patent reexamination system. These

seven new sections would constitute chapter 30 of title 35 of the United States Code.

Section 301. Citation of prior art

Section 301 provides statutory authority for the citation to the Patent and Trademark Office (PTO) of prior art consisting of patents or printed publications which a person believes to have a bearing on the patentability of any claim of a particular patent. Section 301 would make clear that a citation of prior art is not to be included in the official file on a patent unless the citer submits a written statement as to the pertinency and applicability to the patent. Section 301 also would require the PTO to keep the identity of the citer of prior art confidential if the citer so requests in writing. Without the confidentiality provision, competitors of a patent owner might be reluctant to cite prior art to the PTO.

Section 302. Request for reexamination

Section 302 provides authority for any person to seek reexamination by the PTO on the basis of the patents and printed publications cited under section 301. Such a person need not be the one who cited prior art under section 301. The person could even be the patentee.

Section 302 requires that the person seeking reexamination pay a fee established by the Secretary. Under section 2 of this bill, the Secretary would be required to establish a fee to recover the estimated average cost of a reexamination proceeding. Thus, those who request reexamination would pay for it.

Section 302 requires the Commissioner to send a copy of

the request promptly to the patent owner, as shown by the records of the Office. The patent owner would have to see that his ownership and current address are recorded properly so that the request is not sent to a previous owner.

Section 303. Determination off issue by Commissioner

Subsection 303(a) requires the Commissioner to determine if a "substantial new question of patentability" is raised in connection with any claims of the patent against which a patent or printed publication is cited and to order reexamination upon a positive determination. Further, it would permit the Commissioner to initiate reexamination without a request upon a determination that a substantial new question of patentability is raised by patents or publications discovered by him or cited under the provisions of section 301. This authority to initiate reexamination without a request is not intended to abrogate in any way the right of the United States to sue to cancel a patent obtained by fraudulent means.

This "substantial new question" requirement would protect patentees from having to respond to, or participate in unjustified reexaminations. Further, it would act to bar reconsideration of any argument already decided by the Office, whether during the original examination or an earlier reexamination.

Subsection 303(b) requires that the Commissioner's determination be recorded in the file of the patent and a copy promptly sent to the patent owner and the person requesting the reexamination.

Subsection 303(c) makes final and nonappealable a decision by the Commissioner not to conduct reexamination. In such a

case, however, a portion of the reexamination fee could be returned.

No one would be deprived of any legal right by a denial by the Commissioner of a request for reexamination. A party to a reexamination proceeding could still argue in any subsequent litigation that the PTO erred and that the patent is invalid on the basis of the cited prior art.

Section 304. Reexamination order by Commissioner

Section 304 specifies the initial steps to be taken where the Commissioner determines that reexamination should be ordered. Upon issuance of a determination ordering reexamination, the patent owner would be given the opportunity to file a statement with the Office and, if he wishes, to propose an amendment to the specification or claims of his patent as well as a new claim or claims in response to the Commissioner's determination. The patent owner would be required to serve a copy of any such statement and any proposed amendment on the person requesting reexamination who would be permitted to file a reply with the Office, with service required on the patent owner.

Section 305. Conduct of reexamination proceedings

Section 305 governs the conduct of the actual reexamination proceeding. Section 305 specifies that after the initial exchange permitted under section 304, the PTO will utilize the same procedures it uses for the initial examination of patent applications under patent law sections 132 and 133. The patent owner could propose an amendment to his patent specification or claims, as well as propose a new claim or claims, to distinguish his invention from the prior art cited under section

301. However, the bill would prohibit the Commissioner from granting during reexamination any amended or new claim that enlarges the scope of a claim of the original patent. Also, the bill would require reexamination to be promptly handled, so as to make it as helpful as possible.

Section 306. Appeal

Section 306 grants a patent owner the right to pursue the same appeal routes available to patent applicants. An adverse decision on reexamination by the primary examiner could be appealed to the Board of Appeals. Adverse final decisions on reexamination by the Board of Appeals or by the Commissioner could be appealed to the U.S. Court of Customs and Patent Appeals or de novo review of the reexamination decision could be sought in the United States District Court for the District of Columbia.

Section 307. Certificate of patentability, unpatentability, and claim cancellation

Section 307(a) requires the Commissioner at the conclusion of reexamination to cancel any patent claim found to be unpatentable, confirm any patent claim found to be patentable, and add any amended or new claims found to be patentable.

Subsection 307(b) provides intervening rights similar to those provided by patent law section 252 with respect to reissued patents. Thus, a person practicing a patented invention would not be considered an infringer for the period between issuance of an invalid patent and its conversion through reexamination to a valid patent.

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It ordinarily is in the interests of both parties to expedite the disposition of patent litigation. A party discovering new prior art on which reexamination might be conducted ordinarily will reveal it promptly to the patent owner. If he does not, the court may exercise its equity power by allowing the patent owner to request reexamination later in the trial, or precluding the party from relying on such prior art or by other appropriate measures.

ADMINISTRATIVE FEE SETTING

Section 2 of the bill would restructure and modernize completely section 41 of title 35, United States Code — the basic fee provision of the patent laws.

The committee recognizes that the PTO, in issuing patents and registering trademarks, performs a significant public service in implementing the Federal patent and trademark laws and also confers benefit on private persons who seek to protect their intellectual property. The Committee, therefore, supports the premise that patent applicants and those seeking to register trademarks should bear a significant share of the cost of operating the PTO by the payment of fees. However, the Committee has made certain amendments to the formula which empowers the Commissioner to set these fees. Certain costs of operating the PTO confer no direct benefit on applicants but rather go to meet the responsibility of the Federal Government to have a PTO in order to execute the law. For example, the cost of executive direction and administration of the office, including the Office of the Commissioner and certain agency offices involved with public information, legislation, international affairs and technology assessment. Maintaining the public search room confers a general public benefit, as does the maintenance of the patent files in depository libraries. The contribution to

the World Intellectual Property Organization relative to the Patent Cooperation Treaty is a treaty obligation. These costs should be paid for entirely from appropriated funds.

The committee inserted the word "actual" in this legislation to describe those costs which should be assumed 50 percent by applicants. Patent applicants should bear through the payment of fees, 25 percent in processing of fees, and 25 percent in maintenance . . .

* * *

3. Bill status: As ordered reported by the House Committee on the Judiciary on August 20, 1980.

4. Bill purpose: The bill would establish the Patent and Trademark Office (PTO) as an independent agency, removing it from the Department of Commerce (DOC). It would provide for a system of administrative reexaminations, establish a new fee structure, and create a uniform government policy regarding patent rights. H.R. 6933 would require the General Accounting Office (GAO) to report on the desirability of merging the PTO with the Copyright Office and the copyright Royalty Tribunal. The PTO would also be required to report every six months on the progress being made towards implementation of a computerized data and retrieval system. Finally, H.R. 6933 repeals section 117 of the 1976 Copyright Act to clarify copyright laws regarding computer programs.

5. Cost estimate: The table below reflects the budget impact resulting from a change proposed by H.R. 6933 in the classification of the fees received by the PTO.

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[By fiscal years in millions of dollars]

	1981	1982	1983	1984	1985
Revenue reduction	1.8	23.2	23.8	24.3	24.8
Net spending reduction:					
Estimated authorization level	1.5	23.7	24.7	25.6	31.6
Estimated outlays	2.0	24.6	24.7	25.6	31.6
Net budget impact[1]	-0.2	-1.4	-0.9	-1.3	-6.8

The costs of this bill fall primarily within budget subfunction 376.

6. Basis of estimate: For purposes of this estimate, it is assumed that this bill will be enacted around October 1, 1980.

Reexamination of patents

H.R. 6933 would allow any party to petition the PTO to reexamine a patent for validity. The cost of reexamination would be paid by the party based on a fee structure established by the Commissioner of Patents. It is anticipated that the number of patent applications for reexaminations will be limited by the cost involved and the potential for commercial development. Based on rates currently available in foreign countries for similar procedures, as well as estimates provided by the PTO, it is estimated that the number of appeals will be approximately 500 in fiscal year 1981, increasing to 2,000 by 1982, and remain relatively stable thereafter.

Although the bill does not specifically authorize funding for this purpose, it is assumed that additional staff will be required to handle the reexamination procedures. Based on PTO

1. Negative sign indicates increased surplus or decreased deficit.

data, it is estimated that the average cost per employee, including overhead and benefits, would be approximately $40,000 in fiscal year 1981. Assuming approximately 30 hours per reexamination, plus clerical support, it is estimated that approximately 55 appeals could be reviewed annually by a professional staff member. It is estimated that the cost of this procedure would be approximately $0.4 million in fiscal year 1981, which reflects six months' activity. Costs are estimated to be $1.4 million in fiscal year 1982, increasing to $2.5 million by fiscal year 1985. It is assumed, however, that the full amount required by the PTO for salaries and expenses would be recovered by fees set at the beginning of the fiscal year and adjusted annually for inflation and anticipated workload. It is assumed that the fees would be included with the request for reexamination and reflected as a reimbursable to the agency, resulting in a net outlay of around zero in each fiscal year.

Revision of fee structure

H.R. 6933 would restructure the current fee structure for patents and trademarks. Currently, the PTO recovers approximately 20 percent of the cost of processing patents and approximately 30 percent of the cost of issuing trademarks. These fees are deposited in the general fund of the Treasury.

The bill would allow the PTO to recover up to 25 percent of the average processing costs and 25 percent of the maintenance costs for patents, the latter fee collected in four installments over the life of the patent. In addition, the PTO would be allowed to recover a maximum of 50 percent of the cost of issuing trademarks. All fees for patents and trademarks could be adjusted no more than once every three years and would be credited to the PTO as a reimbursable to the agency, rather than as a revenue to the Treasury.

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It is assumed that the revised fee structure for trademarks would be implemented early in the second quarter of fiscal year 1981, and for patents beginning in fiscal year 1982. It is assumed that the agency costs for processing patents and trademarks from which recovery could be made would be approximately $84 million in fiscal year 1982, increasing to approximately $109 million by fiscal year 1985. It is assumed that an average recovery rate of 25 and 50 percent, adjusted every third year, would be established for processing fees for patents and for trademarks, respectively. Patent maintenance fees would be collected three times in a patent's life — around the fourth, eighth, and twelfth year. Since the first payment would not be made until fiscal year 1986, it is not reflected in the table below.

[By fiscal years, in millions of dollars]

	1981	1982	1983	1984	1985
Existing fee structure —					
Estimated revenues:					
Patents	20.3	20.8	21.3	21.8	22.2
Trademarks	2.4	2.4	2.5	2.5	2.6
Total	22.7	23.2	23.8	24.3	24.8
Proposed fee structure in H.R. 6933 —					
Estimated collections:					
Patents[1]	[2]20.3	21.2	21.2	21.2	27.2
Trademarks	3.6	3.6	3.6	4.6	4.6
Total	23.6	24.8	24.8	25.8	31.8
Net budget impact	-0.9	-1.6	-1.0	-1.5	-7.0

1. Maintenance fees would be collected beginning in fiscal year 1986, and by fiscal year 1994 would result in revenues approximately twice those estimated for processing.

2. The current fee structure for patents remains in effect throught fiscal year 1981.

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CONGRESSIONAL BUDGET OFFICE COST ESTIMATE

SEPTEMBER 23, 1980

1. Bill number: H.R. 6933.

2. Bill title: A bill to amend the patent and trademark laws.

3. Bill status: As ordered reported by the House Committee on Government Operations on September 23, 1980.

4. Bill purpose: This bill would establish a new fee structure within the Patent and Trademark Office (PTO), provide for a system of administrative reexaminations, and create a uniform government policy regarding patent rights. The PTO would also be required to implement a computerized data and retrieval system. In addition, H.R. 6933 would repeal section 117 of the 1976 Copyright Act to clarify copyright laws regarding computer programs.

5. Cost estimate: The table below reflects the budget impact resulting from a change proposed by H.R. 6933 in the classification of the fees received by the PTO.

[By fiscal years in millions of dollars]

	1981	1982	1983	1984	1985
Revenue reduction	1.8	23.2	23.8	24.3	24.8
Net spending reduction:					
Estimated authorization level	1.9	23.8	24.8	25.8	31.8
Estimated outlays	2.4	24.7	24.8	25.8	31.8
Net budget impact[1]	-.6	-1.5	-1.0	-1.5	-7.0

1. Negative sign indicates increased surplus or decreased deficit.

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The costs of this bill fall primarily within budget subfunctions 376.

6. Basic of estimate: For purposes of this estimate, it is assumed that this bill will be enacted around October 1, 1980.

REEXAMINATION OF PATENTS

H.R. 6933 would allow any party to petition the PTO to reexamine a patent for validity. The cost of reexamination would be paid by the party based on a fee structure established by the Commissioner of Patents. It is anticipated that the number of patent applications for reexaminations will be limited by the cost involved and the potential for commercial development. Based on rates currently available in foreign countries for similar procedures, as well as estimates provided by the PTO, it is estimated that the number of appeals will be approximately 500 in fiscal year 1981, increasing to 2,000 by 1982, and remain relatively stable thereafter.

Although the bill does not specifically authorize funding for this purpose, it is assumed that additional staff will be required to handle the reexamination procedures. Based on PTO data, it is estimated that the average cost per employee, including overhead and benefits, would be approximately $40,000 in fiscal year 1981. Assuming approximately 30 hours per reexamination, plus clerical support, it is estimated that approximately 55 appeals could be reviewed annually by a professional staff member. It is estimated that the cost of this procedure would be approximately $0.4 million in fiscal year 1981, which reflects six months' activity. Costs are estimated to be $1.4 million in fiscal year 1982, increasing to $2.5 million by fiscal year 1985. It is assumed, however, that the full amount required by the

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PTO for salaries and expenses would be recovered by fees set at the beginning of the fiscal year and adjusted annually for inflation and anticipated workload. It is assumed that fees would be included with the request for reexamination and reflected as a reimbursable to the agency, resulting in a net outlay of around zero in each fiscal year.

REVISION OF FEE STRUCTURE

H.R. 6933 would restructure the current fee structure for patents and trademarks. Currently, the PTO recovers approximately 20 percent of the cost of processing patents and approximately 30 percent of the cost of issuing trademarks. These fees are deposited in the general fund of the Treasury.

The bill would allow the PTO to recover up to 25 percent of the average processing costs and 25 percent of the maintenance costs for patents, the latter fee collected in four installments over the life of the patent. In addition, the PTO would be allowed to recover a maximum of 50 percent of the cost of issuing trademarks. All fees for patents and trademarks could be adjusted no more than once every three years and would be credited to the PTO as a reimbursable to the agency, rather than as a revenue to the Treasury.

It is assumed that the revised fee structure for trademarks would be implemented early in the second quarter of fiscal year 1981, and for patents beginning in fiscal year 1982. It is assumed that the agency costs for processing patents and trademarks from which recovery could be made would be approximately $84 million in fiscal year 1982, increasing to approximately $109 million by fiscal year 1985. It is assumed that an average recovery rate of 25 and 50 percent, adjusted every third year,

would be established for processing fees for patents and for trademarks, respectively. Patent maintenance fees would be collected three times in a patent's life — around the fourth, eighth, and twelfth year. Since the first payment would not be made until fiscal year 1986, it is not reflected in the table below.

[By fiscal years, in millions of dollars]

	1981	1982	1983	1984	1985
Estimated revenues:					
Existing fee structure:					
Patents	20.3	20.8	21.3	21.8	22.2
Trademarks	2.4	2.4	2.5	2.5	2.6
Total	22.7	23.2	23.8	24.3	24.8
Proposed fee structure in H.R. 6933:					
Estimated collections:					
Patents[1]	[2]20.3	21.2	21.2	21.2	27.2
Trademarks	3.6	3.6	3.6	4.6	4.6
Total	23.6	24.8	24.8	25.8	31.8
Net budget impact	-0.9	-1.6	-1.0	-1.5	-7.0

1. Maintenance fees would be collected beginning in fiscal year 1986, and by fiscal year 1994 would result in revenues approximately twice those estimated for processing.

2. The current fee structure for patents remains in effect through fiscal year 1981.

APPENDIX O — EXCERPTS OF THE MANUAL OF PATENT EXAMINING PROCEDURE

Manual of Patent Examining Procedure
Original Sixth Edition, January 1995
Latest Revision, July 1996

Manual of

PATENT EXAMINING PROCEDURE

Original Sixth Edition, January 1995
Latest Revision July 1996

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

* * *

2. Nonobviousness Type

There are some unique circumstances where it has been recognized that another type of nonstatutory double patenting rejection is applicable even where the inventions claimed in tow or more applications/patents are considered nonobvious over each other. These circumstances are illustrated by the facts before the court in *In re Schneller,* 397 F.2d 350, 158 USPQ 210 (CCPA 1968).

Schneller disclosed an invention relating to a wire clip having three elements known in the prior a.:t (A, B, and C), and two features (X and Y) which he had invented that could be used separately or in combination. Schneller acknowledged the best mode of his invention used the two features (X and Y) in combination. The claims of the patent were directed to a wire

clip comprising ABCX, Schneller voluntarily filed a divisional application claiming wire clips comprising ABCY and ABCXY. Without determining that the combination ABCX claimed in the patent, the court affirmed the double patenting rejection. It was observed that the claims in both the patent and the application cover the preferred embodiment disclosed in both the application and the patent (ABCXY). Since patent protection for the metal clips defined by ABCXY, fully disclosed in and covered by the claims of the appealed claims, the double patenting rejection was affirmed.

In making an analysis for this type of nonstatutory double patenting, the first question is: Is the subject matter recited in the claims of the application fully disclosed in the patent and covered by a claim in the patent? If the answer is yes, the second question is: Is there any reason why applicant was prevented from presenting the same claims for examination in the issued patent? If the answer is no, a double patenting rejection is appropriate.

A fact situation similar to that in Schneller was presented to a Federal Circuit panel in *In re Kaplan*, 789 F.2d 1574, 229 USPQ 678 (Fed. Cir. 1986). Kaplan had been issued a patent on a process of making chemicals in the presence of an organic solvent. Among the organic solvents disclosed and claimed as being useful were tetraglyme and sulfolane. One unclaimed example in the patent was specifically directed to a mixture of these two solvents. The claims in the application to Kaplan and Walker, the application before the Office, were directed to essentially the same chemical process, but requiring the use of the solvent mixture of tetraglyme and sulfolane. In reversing the double patenting rejection, the court stated that the mere fact that the broad process claim of the patent requiring an

organic solvent reads on or "dominates" the narrower claim directed to basically the same process using a specific solvent mixture does not, per se, justify a double patenting rejection. The court also pointed out that the double patenting rejection improperly used the disclosure of the jointinvention (solvent mixture) in the Kaplan patent specification as thought it were prior art.

A significant factor in the *Kaplan* case was that the broad invention was invented by Kaplan, and the narrow invention (i.e., using a specific combination of solvents) was invented by Kaplan and Walker. Since these applications (as the applications in Braat) were filed before the Patent Law Amendments Act of 1984 (Pub. Law 98-622, November 8, 1984) amending 35 U.S.C. 116 to expressly authorize filing a patent application in the names of joint inventors who did not necessarily make a contribution to the invention defined in each claim in the patent, it was necessary to file multiple applications to claim both the broad and narrow inventions. Accordingly, there was a valid reason, driven by statute, why the claims to the specific solvent mixture were not presented for examination in the Kaplan patent application.

Each double patenting situation must be decided on its own facts. To the extent that one would view the *Schneller* and *Kaplan* decisions to be in conflict, it is clear that *Schneller* is the controlling precedent. Decisions of a three-judge panel of the Federal Circuit cannot overturn prior presidential decisions of the CCPA, See *UMC Elec. Co. v. United States*, 816 F.2d 647, 2 USPQ2d 1465 (Fed. Cir. 1987), *cert denied*, 484 U.S. 1025 (1988).

Form paragraph 8.33 and the appropriate one of 8.38

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(between an issued patent and one or more applications) and 8.39 (provision rejections) may be used to make nonstatutory double patenting rejections of the nonobvious type.

¶ *8.38 Double Patenting — Non-statutory, Non-obvious With a Patent*

Claim [1] rejected under the judicially created doctrine of double patenting over claim [2] of U.S. Patent No. [3] since the claims if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: [4].

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Examiner Note:

1. This form paragraph must be preceded by form paragraph 8.33.

2. Use this form paragraph only when the subject matter of the claim(s) is fully disclosed in, and covered by, at least one claim of an issued U.S. Patent which is commonly owned or where there is common inventorship (one or more inventors in common).

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3. In bracket 3, insert the number of the patent.

4. Form paragraph 8.33 must precede any one of paragraphs 8.34 to 8.39 and must be used only ONCE in an Office action.

5. If evidence indicates that the conflicting patent is prior art under 35 U.S.C. 102(f) or (g), a rejection should additionally be made under 102(f)/103>(a)< or 102(g)/103 >(a)< using paragraph 7.21.

6. If the patent is to another inventive entity and has an earlier U.S. Filing date, a rejection under 35 U.S.C. 102(e) or 102(e)/103 >(a)< may be made using paragraphs 7.15.02 or 7.21.02.

* * *

APPENDIX P — ORDER AND DECISION IN THE UNITED STATES DEPARTMENT OF COMMERCE PATENT AND TRADEMARK OFFICE DATED OCTOBER 3, 1994

ORDER GRANTING/DENYING REQUEST FOR REEXAMINATION

The request for reexamination has been considered. Identification of the claims, the references relied on, and the rationale supporting the determination are attached.

Attachment(s): ❑ PTO-892, ❑ PTO-1449, ❑ Other: ____

1. ☑ The request for reexamination is GRANTED.

RESPONSE TIMES ARE SET TO EXPIRE AS FOLLOWS:

For Patent Owner's Statement (optional): TWO MONTHS from the mailing date hereof. 37 CFR 1.530(b). EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).

For Requester's reply (optional): TWO MONTHS from the date of service of any patent owner's statement 37 CFR 1.535. NO EXTENSION OF TIME IS PERMITTED. If patent owner does not file a timely statement under 37 C.F.R. 1.530(b), no reply by requester is permitted.

* * *

DECISION

A substantial new question of patentability affecting claims 1-6

of United States Patent number 5,298,013 to Lonardo is raised by the request.

The request indicates the requestor considers that claims 3, 4, and 6 of Lonardo ['013] are fully anticipated by the prior art patent document of Baker, U.S. Patent 3,527,209 under 35 U.S.C. 102, and that claims 1, 2, and 5 are obvious over Baker ['209] under 35 U.S.C. 103.

It is agreed that the consideration of the Baker patent document raises a substantial new question of patentability as to claims 1-6 of the Lonardo ['013] patent. The Baker patent is material to the examination of the claims of the Lonardo patent as pointed out in the request.

The prior art documents listed under "Other Documents" on the requestor's form PTO/SB/42 have not been considered in the decision as to whether a substantial new question of patentability exists because the Appendix of this reexamination application appears to be incomplete in that "Tabs 1-10" are missing. As reexamination has been granted on all of the claims, 1-6, the requestor is asked to please resubmit the Appendix as originally filed for consideration upon reexamination of the application.

s/ L Dvorak
LCM Dvorak
October 3, 1994

s/ Richard J. Apley
Richard J. Apley
Supervisory Pat. Exr.
Art Unit 3302

cc: David W. Pettis, Jr.
Pettis & Mcdonald, P.A.
P.O. Box 1528
Tampa, Florida 33601-1528

APPENDIX Q — RE 33,762

(Omitted here but submitted separately as Lodging Appendix)

APPENDIX R — PATENT NO. 5,269,748

(Omitted here but submitted separately as Lodging Appendix)

APPENDIX S — PATENT NO. 5,298,013

(Omitted here but submitted separately as Lodging Appendix)

APPENDIX T — PATENT APPLICATION SERIAL NO. 08/218,756

(Omitted here but submitted separately as Lodging Appendix)